



#16
293

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert B. Harkness and Philip A.
Harkness

Art Unit: 1661

Application No. 09/255,107

Filed: February 22, 1999

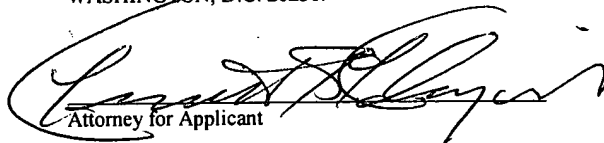
For: CLIMBER ROSE PLANT NAMED HARYUP

Examiner: Howard J. Locker

Date: August 29, 2002

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on August 29, 2002 as First Class Mail in an envelope addressed to: COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231.


Attorney for Applicant

COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

TRANSMITTAL LETTER

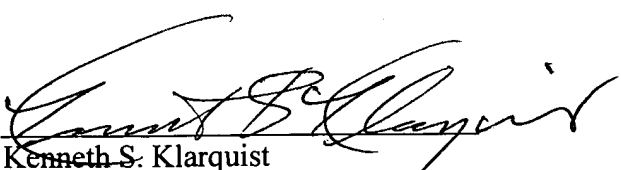
Enclosed for filing in the application referenced above are the following:

- ☒ Appellant's Appeal Brief (in triplicate).
- ☒ Appendix A and Appendix B.
- ☒ A check in the amount of \$320.00 is attached for the filing of the Appeal Brief.
- ☒ Please charge any additional fees which may be required in connection with filing this Appeal Brief, or credit any overpayment, to Deposit Account No. 02-4550. A copy of this sheet is enclosed.
- ☒ Please return the enclosed postcard to confirm that the items listed above have been received.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By:


Kenneth S. Klarquist
Registration No. 16,445

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 226-7391
Facsimile: (503) 228-9446
cc: Docketing

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Robert B. Harkness &
Philip A. Harkness

Art Unit: 1661

Application No. 09/255,107

Filed: February 22, 1999

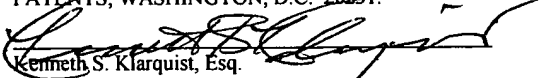
For: CLIMBER ROSE PLANT NAMED
HARYUP

Examiner: Howard J. Locker

Date: August 29, 2002

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as
being attached or enclosed herewith are being deposited with the
United States Postal Service on August 29, 2002 as First Class
Mail in an envelope addressed to: COMMISSIONER FOR
PATENTS, WASHINGTON, D.C. 20231.


Kenneth S. Klarquist, Esq.
Attorney for Applicant

COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

APPELLANTS' APPEAL BRIEF

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	5
II.	RELATED APPEALS AND INTERERENCES	5
III.	STATUS OF CLAIMS	5
IV.	STATUS OF AMENDMENTS	5
V.	SUMMARY OF THE INVENTION	5
VI.	ISSUE.....	5
VII.	GROUPING OF CLAIMS.....	6
VIII.	ARGUMENT	7
A.	The Examiner's Position Was Rejected By The Court of Customs And Patent Appeals Forty Years Ago.....	7
B.	<u>Ex Parte Thomson</u> Was Wrongly Decided Because Of Its Mistaken Interpretation Of The Facts Present in <u>In re LeGrice</u>	15
C.	<u>Ex Parte Thomson</u> Was An Anomaly, Should Not Be Followed, And Should Be Overruled.....	16
D.	<u>Ex Parte Thomson</u> Is Distinguishable From The Present Case	19
E.	The Rejection Herein Under Section 102(b), Is Not Authorized By And Is Contrary To The Manual Of Patent Examining Procedure And To The Law	19
F.	The Basis Of Rejection Herein Advanced Constitutes A Reversal Of Policy Followed For Seventy Years And Will Have A Devastating Effect Upon The Plant Industry If Allowed To Continue.....	21
G.	Sale Of A Product In A Foreign Country Has Never Been Held To Enable An Otherwise Non-Enabling Disclosure Of A Mechanical Product	23
H.	Enabling Publication Should Be One That Puts Public In Permanent Possession Of Invention - Not For Some Indeterminate Period	23
I.	Conclusion	24

Appendix A	25
Appendix B	26

TABLE OF AUTHORITIES

Cases

<u>Ex parte Thomson</u> , 24 USPQ 2d 1618 (Board of Patent Appeals and Interferences, 1992)	passim
<u>In re Donohue</u> , 766 F2d 531, 533, 226 USPQ 619 (Fed. Cir. 1985).....	10, 11, 13, 20, 21
<u>In re LeGrice</u> , 301 F. 2d 929, 133 USPQ 365 (CCPA 1962)	passim
<u>In re Samour</u> , 571 F2d 559, 197 USPQ 1 (CCPA 1978)	20, 21
<u>Kalman v. Kimberly-Clark Corp.</u> , 713 F2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983).....	20
<u>Seymour v. Osborn</u> , 78 U.S. 510, 555 (1870)	11

Statutes

35 USC 102(b)	passim
---------------------	--------

Other Authorities

Manual of Patent Examining Procedure ("MPEP") 700-10	19, 20
--	--------

I. REAL PARTY IN INTEREST

The real party in interest is Jackson & Perkins Wholesale, Inc., a corporation of Delaware, owner of the application by virtue of an assignment recorded at Reel/Frame 9793/0577, February 22, 1999.

II. RELATED APPEALS AND INTERERENCES

Notices of Appeal have been filed in Applications 09/267,559, filed 3/12/99; 09/448,248, filed 11/24/99; 09/458,119, filed 12/8/99; 09/286,130, filed 4/2/99; 09/465,416, filed 12/16/99; 09/340,171, filed 6/25/99; 09/344,360, filed 6/25/99; and 09/580,335, filed 5/26/00 finally rejected for reasons similar to those advanced in the subject application.

III. STATUS OF CLAIMS

This application has a single claim which stands finally rejected.

IV. STATUS OF AMENDMENTS

No amendments after final have been filed. All previously filed amendments have been entered.

V. SUMMARY OF THE INVENTION

Applicants' invention relates to a new and distinct variety of climber rose plant developed by cross-breeding two unpatented rose varieties.

VI. ISSUE

Was the single claim of the application properly rejected under 35 USC 102(b) upon the basis of publications describing the rose plant of the application in foreign countries more than one year before the application was filed and the sale of plants of the rose variety of the application outside of (but not within) the United States more than one year before the application was filed. Specifically, the issue is whether such availability for sale of the rose

plants "enabled" the cited publications which the examiner admitted "standing alone would not have enabled one skilled in the art to practice the claimed invention."

VII. GROUPING OF CLAIMS

There is only a single claim.

APPEAL BRIEF

ARGUMENT

THE EXAMINER'S POSITION WAS REJECTED BY THE COURT OF CUSTOMS AND PATENT APPEALS FORTY YEARS AGO

The issue presented herein is whether this application for plant patent on a rose plant was properly rejected under 35 USC 102(b) on the basis of publications describing the rose plant more than one year before the application, which publications the Examiner admitted “standing alone would not enable one skilled in the art to practice the claimed invention,” (Office Action 6/25/02), and a stipulation that the rose plant was on sale in a foreign country (but not in the U.S.) more than one year before the application, the Examiner holding that such sale made the publications enabling. (The cited publications were documents associated with plant breeder's rights applications filed in New Zealand and the United Kingdom to secure plant breeder's rights protection on the rose variety HARyup.)

Almost exactly forty years ago the Court of Customs and Patent Appeals rendered its decision in a joint appeal of rejections of two plant patent applications seeking plant patent protection on two rose varieties each of which had been the subject of printed publications describing the rose of the application more than one year before the filing date of the application, and each of which had been offered for sale in a foreign country more than one year before the U.S. application therefor had been filed, facts identical to those present in the application at issue. The joint appeals were from a Patent Office Board of Appeals decision which sustained the rejection of the applications by the Examiner under 35 USC 102(b) on the ground that the plant varieties of the application were “described in a printed publication more than one year prior to the date of application for patent in the United States.” The Board of

Appeals in sustaining the rejections of the applications noted that both of the plants had been on sale in a foreign country but held such sales to be irrelevant. The CCPA reversed the decision of the Board in both appeals, ruling that to be a basis for a 102(b) rejection a publication has to be enabling and that a publication describing a rose plant was not enabling. It did not hold that the Board was wrong in finding the fact of sale to be irrelevant and the court did not hold that the fact of sale made the publications enabling. That decision was In re LeGrice, 301 F. 2d 929, 133 USPQ 365 (CCPA 1962).

Although in the Final Action the Examiner conceded “(t)he text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention,” the Examiner held the sales outside of the United States more than one year prior to the filing date of the instant application enabled the referenced publications “because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have knowledge of how to do so, given the notoriety of various methods of asexual propagation.” (Final Office Action June 28, 2002, page 4).

This basis of rejection flies in the face of In re LeGrice, (supra) which held that a description of a rose plant standing alone was insufficient to provide an enabling disclosure to support a rejection under 35 USC 102(b) and which did not find that the fact of prior sale of the plant made such a disclosure enabling.

Since the Decision of the Board of Appeals in the LeGrice applications was never published, there is submitted herewith as APPENDIX B to this brief a copy of the TRANSCRIPT OF RECORD in the appeal of such Decision to the CCPA. The Decision of the Board of Appeals, February 12, 1960, appears at pages 22-27 of the RECORD. The conclusion of the Board of Appeals that the plants of the LeGrice applications were on sale appears in the last paragraph on page 22 of the RECORD. On that same page the Board states

that the public use or sale was “not in issue since the public use or sale must be in the United States in order to bar a patent,” and restates that point at page 25. (The attached TRANSCRIPT OF RECORD was obtained from the records of the Court of Appeals for the Federal Circuit.)

Review of the Board decision in LeGrice is further educational with respect to the issues presented to the CCPA in the appeal of the Board’s decision. The Board clearly conceded the position of the Appellant that the written descriptions in the cited publications were not enabling by themselves. (See the discussion in the paragraph beginning at the bottom of page 23 of the RECORD and the succeeding portion of the Board’s decision.) It eventually held the references to be sufficient to support the rejection of the respective applications because as they “adequately identify the claimed plants, it follows from these holdings that the appealed claims were properly rejected regardless of the question of sufficiency of the referenced disclosures as to how to produce the plants.” RECORD, page 27.

It is notable that the Board of Appeals in LeGrice did not consider the fact that the plants of the appealed applications having been on sale made the cited references enabling. It held in its decision that the sale was irrelevant.

On appeal, the Court of Customs and Patent Appeals reversed the Board of Appeals, noting that the term “described in a printed publication” to support a rejection of a claim “requires that the description of the invention in the printed publication must be an ‘enabling’ description.” (301 F2d at 939, 133 USPQ at 373). The court in LeGrice simply and plainly held that a description of a plant “just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in possession of those

so skilled.” (301 F2d at 944, 133 USPQ at 378). In other words, it ruled it was necessary that by reason of the description a person of ordinary skill in the art could produce the plant of the publication from some starting material or materials other than the plant itself. It did not hold that a publication describing a plant coupled with evidence that the plant was on sale in a foreign country and its numbers multiplied by asexual propagation if any part of the such plant could be obtained would bar a patent, but rather it held that the description and skills (then and now unavailable) together must be sufficient to enable one of ordinary skill to produce the plant of the description. Not to multiply the number of existing plants, but to “make” the plant of the invention from source material other than the plant itself.

This is clearly indicated in its opinion where the Court, after discussing how new varieties are hybridized by sexual propagation and new varieties multiplied by asexual reproduction (301 F2d at 933, 133 USPQ at 372-373), discusses why the printed publications relied upon in rejection of the applications at issue could not be relied upon as a statutory bar, to wit:

While the present knowledge of plant genetics may mean as a practical matter, that the descriptions in such general publications as are here involved cannot be relied upon as a statutory bar under section 102(b), we must be mindful of the scientific efforts which are daily adding to the store of knowledge in the fields of plant heredity and plant eugenics⁷ which one skilled in this art will be presumed to possess. (133 USPQ at 374)

⁷ While many such studies undoubtedly are in progress, some idea of the possible additions to the knowledge of plant heredity is found in current seed catalog offerings of peanut seeds which by atomic irradiation will produce plants in which the peanuts are produced above the ground. The chemical colchicine also is widely used to modify genetic characteristics of seeds. Current studies to “break the chromosome code” may also add to the knowledge of plant breeders so that they may someday secure possession of a plant invention by a description in a printed publication as is now possible in other fields of inventive effort.

The Court of Appeals Federal Circuit explained further the requirements for an enabling disclosure in In re Donohue, 766 F2d 531, 533, 226 USPQ 619 (Fed. Cir. 1985):

It is well settled that prior art under 35 USC § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. (Citations omitted). Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. (Emphasis added). See In re LeGrice, 301 F2d at 939, 133 USPQ at 373-374.

The significant admonition of the Court in In re Donohue is that a publication describing an invention is enabling only if the invention can be made by one of ordinary skill in the art using the information available from the disclosure and his own skills. In In re Donohue, the question was whether one skilled in the art could “make” a chemical compound disclosed in a reference. Prior art references did disclose chemical reactions that, if used with suitable chemicals, would “make” the compound of the claim and thus the court in In re Donohue affirmed the rejection of the claim to a chemical compound. With current skills, to “make” a new rose requires cross-breeding two rose plants and planting the resulting seeds. (In a hip produced by cross-fertilization of a flower, there can be up to three hundred seeds). The resulting plants each will have unique characteristics and will differ from each parent and from each other. There is no known way to cross-breed two rose plants to “make” a duplicate of an existing rose. Once a new rose plant has been grown from a seed resulting from a cross, the plant can be multiplied by asexual reproduction of parts of the plant, but this is not “to make the claimed invention” as noted in In re Donohue, supra.

The concept that a reference to anticipate an invention must enable the art to practice the invention has been embedded in the law for over a century. The Supreme Court in Seymour v. Osborn, 78 U.S. 510, 555 (1870) stated the rule as follows:

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to

which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defense, must be an account of a complete and operative invention capable of being put into practical operation.

No one however skilled could have made, bred or otherwise derived the HARYup rose plant of this application from information in the publications relied upon by the Examiner.

As noted above, the LeGrice Board concluded in its Opinion that the rose plants of the applications on appeal were “on sale” but held such fact to be irrelevant. If the LeGrice Court had considered such sales to be relevant to the enablement of the disclosures in question, it would certainly have said so. Thus, it is clear that public availability or the offer for sale in some foreign country of the plant of a patent application is not relevant to the determination of whether the written description of the plant of the application is an enabling description. It clearly is not.

In the first paragraph on page 5 of the Final Action, it is argued that “(t)here is no requirement that a printed publication that describes the invention be printed or enabled in this country.” That is true, but a publication describing a rose plant is inherently non-enabling no matter where it is printed!

In the next paragraph it is argued that applicant herein is “attempting to create a geographic component of enablement.” This is not correct. Applicant herein has pointed out no sales of HARYup were made in the U.S. more than one year before the application was filed to negate any reliance upon 35 USC 102(b) by reason of any sales in the United States.

As to the sales in any foreign country before the application was filed, such sales are irrelevant to the enablement of the relied upon publications for the reason that they do not enable anyone “to make” the HARYup rose. In re Donohue, 766 F2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). From cuttings of plants sold in foreign countries multiple HARYup roses could be produced by grafting but this is not a “making” of the invention based on the descriptions contained in the publications disclosing the HARYup rose.

The Examiner, argues at page 6, that the applicant herein is not correct in his contention that the plants in In re LeGrice were on sale. In support of this argument, the Examiner contends that in LeGrice “applicant never admitted that the rose cultivar was on sale anywhere. Instead applicant stated, 'Prior public use or sale are the avenues by which a plant enters the public domain.'” This sentence, quoted in LeGrice, 301 F2d at 935, 133 USPQ at 370-371, is the concluding sentence in a paragraph beginning at page 7 of LeGrice’s brief to the court, to the effect that a publication describing a plant cannot enable others to reproduce the plant or place it in the public domain, to wit:

The description of a plant in a plant patent or in a printed publication at best can only recite, as historical facts, that at one time a certain plant existed, was discovered in a certain manner, and was asexually reproduced. This information may be interesting history, but cannot enable others to reproduce the plant. Therefore, no matter the age of the publication, it cannot take from the public that which had long before been invented and, by publication, placed in public domain. Prior public use and sale of a plant are the avenues by which a plant enters the public domain. (See APPENDIX B hereto.)

This was not a denial that the rose plants of the LeGrice applications were “on sale” in England, but was made in rebuttal to the contention of the Board that the publications and catalogs placed the plants in the public domain. And, of course, such sale must be in the United States to constitute relevant prior art under 35 USC 102(b).

In the concluding paragraph on page 6, the Examiner argues that the fact the LeGrice Court knew the plant was on sale is “contrary to the written opinion” therein. He proceeds to argue that the “LeGrice decision repeatedly returns to the question of whether the “invention was in the possession of the public,” and concludes, “(c)learly, if any invention is on sale to the public, than the public must have possession of it.” The Examiner is confused. The “invention” referred to by the court is the creation of a new rose, or as expressed in *Webster’s Third International Dictionary*, “4a: the creation of something not previously in existence.” The sale of a rose does not educate anyone as to how “to create” it and the sale of the rose cannot therefore put the invention “in the possession of the public.” This is what the LeGrice Court made reference to. As to the Examiner’s reliance on Ex Parte Thomson’s observation that in LeGrice “no indication was given that the prior catalogue publication before it evidenced commercial availability in a readily enabling form,” as noted herein before the Thomson Board did not refer to the record on appeal in LeGrice and was obviously not aware of the finding of the LeGrice Board that the LeGrice roses were on sale.

The Examiner further argues on page 6 of the Action, fourth paragraph, that “(t)he LeGrice decision repeatedly returns to the question of whether the invention was in the possession of the public. Clearly, if an invention is on sale to the public, then the public must have possession of it.”

It is clear that what the LeGrice Court intended by the question of whether the invention was “in the possession of the public” was whether, having the description of the roses in the publications and catalogs, could persons of ordinary skill in the art produce, i.e. “make,” such roses? LeGrice answers that question thusly:

The descriptions of the new roses in the instant publications*, are incapable of placing these roses in the public domain by their description when interpreted in the light of knowledge now possessed

by plant breeders. The roses disclosed in the appealed applications are not, therefore, described in a printed publication” within the meaning of 35 U.S.C. 102(b). *Footnote omitted (301 F2d at 944, 133 USPQ at 378).

That statement is equally applicable here and the sale of the rose of the application in foreign countries did not make the cited publications “enabling” so as to bar the granting of a plant patent upon such rose.

As to the Examiner’s statement that “if an invention is on sale to the public, then the public must have possession of it,” such a broad statement is, of course, wholly in error and contrary to law. 35 U.S.C. 102(b) specifically requires to raise a bar that the invention be “in public use or on sale in this country.” If sale or public use of a plant in a foreign country puts a plant in the “public’s possession” as contended by the Examiner, the mere fact of evidence of sale of a plant in the foreign country would be a basis for holding that such plant was ineligible for patent protection in the United States. There would be no need for a publication describing the plant. This of course is not the law since Section 102 requires that the public use or sale has to be “in the country.”

EX PARTE THOMSON WAS WRONGLY DECIDED BECAUSE OF ITS MISTAKEN INTERPRETATION OF THE FACTS PRESENT IN IN RE LEGRICE

The Examiner relies heavily upon Ex parte Thomson, 24 USPQ 2d 1618 (Board of Patent Appeals and Interferences, 1992) which affirmed a rejection of an application for utility patent claiming a cotton cultivar having the designation ‘Siokra’ and parts of such plant, such as seeds. The Siokra plant had been described in various publications more than one year before the U.S. application was filed and seeds for such plant had been on sale in foreign countries more than one year before the U.S. application was filed. Thomson held that LeGrice was not controlling because “there is no indication that LeGrice had in evidence

the facts supporting commercial availability that are present here” (24 USPQ 2d at 1621), and affirmed the Examiner’s holding the publications were enabled by reason of the availability of the cotton seeds in foreign countries which put the claimed subject matter “in possession of the public” more than one year before the application was filed. The Thomson Board was clearly in error in its conclusion that the LeGrice court did not have “in evidence the facts supporting commercial availability” of the rose plants of the LeGrice applications. The decision of the LeGrice Board clearly dispels that erroneous conclusion of the Thomson Board and the holding in Thomson is clearly contrary to established law and to what is a controlling decision of the appellate court. Moreover, as noted above and as will be discussed at greater length below, being able to grow a plant from seed or reproduce it asexually is not the activity of “placing the invention in the possession of” those skilled in the art, (In re LeGrice, 301 F2d at 944, 133 USPQ at 378) as contemplated by the LeGrice court.

EX PARTE THOMSON WAS AN ANOMALY, SHOULD NOT BE FOLLOWED, AND SHOULD BE OVERRULED

As noted above, the Board in Ex Parte Thomson erroneously concluded “that there is no indication that LeGrice had in evidence the facts supporting commercial availability that are present here.” (24 USPQ 2d at 1621). As the RECORD in LeGrice shows, the catalogs illustrating the rose plants there in issue indicated the plants were on sale and the LeGrice Board noted in its decision that the plants were “on sale.” LeGrice RECORD, page 22. The LeGrice Board went on to note that “the use or sale of the plants in a foreign country would be irrelevant.” RECORD, page 25. Thus, the fact of sale was before the Court in LeGrice and the fact that the Court did not consider it to be relevant to the issue as to whether the publications were enabling is evident from the fact that it made no note of the sale. If the

Court had felt that the fact of sale made the publications enabling it would have said so and affirmed the decision of the LeGrice Board, albeit on modified grounds.

The fact of the matter is that the availability of a plant in a foreign country does not make a non-enabling disclosure of a plant enabling.

The Board in Ex parte Thomson misread the holding in In re LeGrice as is clear from its statement of what it thought was the issue in Thomson, to wit “(t)he issue is not whether the cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.” (Emphasis added) (24 USPQ 2d at 1620). The Thomson Board went on to hold that because seeds of the Siokra cotton plant were on sale and could be purchased by the public and the Siokra cotton plant reproduced from such seeds, the publications of record were thereby enabled. An error of the Thomson Board resided in its equating of the words “make” and “reproduce.” In LeGrice, 301 F2d at 933, 133 USPQ at 369, begins a discussion of what is necessary to provide an enabling prior art disclosure and quotes at length from Robinson on Patents, Sec. 325. The opinion states the point with which the Court was concerned as follows:

It is Robinson’s 5th characteristic of a prior publication with which we are here concerned. This characteristic is further elaborated in Sec. 330 of Robinson on Patents entitled “Prior Publication: Publication Must Fully Communicate the Invention to the public,” which states the rule as follows:

Finally, the description must place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed. In order to accomplish this, it must be so particular and definite that *from it alone, without experiment or the exertion of his own inventive skill*, any person versed in the art to which it appertains could construct and use it. [Emphasis Court’s.]

The critical language pertinent here is Robinson's conclusion that the disclosure must be such that "any person versed in the art to which it appertains could construct and use it." The citation to Robinson is followed by reference to Walker on Patents as follows:

And a claim for an article of manufacture may be anticipated by a prior patent or printed publication, which describes the article, without describing any process of making it; *provided a knowledge of the article would teach a skillful mechanic some process of making it.* (Emphasis Court's) 301 F2d at 934, 133 USPQ at 370.

The emphasis in both of these quoted authorities is that a prior art reference "alone" must permit some person of skill in the art to make the invention. In the case of a plant it would require that from a description a person of skill in the art could breed a plant identical to that in the description. Such skill was not possessed at the time of the LeGrice opinion nor is it possessed now.

Multiplying of an existing plant described in a publication by asexual reproduction is not a "making" of the described plant.

As a matter of fact, Thomson distinguished LeGrice on the ground that "(u)nlike the seeds of the asexually reproduced roses of LeGrice, which would not produce the claimed rose, the sexually reproduce (sic) seeds of the Siokra cultivar do reproduce the claimed Siokra cultivar. Hence, the commercially available seeds themselves enable reproduction of the claimed cotton cultivar." (24 USPQ 2d at 1621.)

Thomson is obviously improperly relied upon to support the rejection of the subject application.

EX PARTE THOMSON IS DISTINGUISHABLE
FROM THE PRESENT CASE

The Board in Ex parte Thomson distinguished that case from LeGrice on two bases. First, it noted that the publications disclosing the claimed cultivar disclosed the seeds of the Siokra plant and the commercial growth of the plant and upheld the Examiner's rejection on the asserted ground "that a person of skill in the art could obtain and reproduce the invention by seed germination without experimentation." (24 USPQ at 1619.)

In addition, it distinguished LeGrice "in that whereas LeGrice concerned a plant patent, applicant seeks a utility patent, which affords a broader scope of protection." (24 USPQ at 1621.)

Here, there was no evidence of commercial availability in the relied upon publications, the evidence of sale of the variety being stipulated by the applicant, and, of course, this is an application for plant patent, not for a utility patent as in Thomson.

**THE REJECTION HEREIN UNDER SECTION 102(b), IS NOT
AUTHORIZED BY AND IS CONTRARY TO THE MANUAL OF PATENT
EXAMINING PROCEDURE AND TO THE LAW**

The MPEP expressly provides: "...for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claim invention, either explicitly or implicitly." (MPEP 700-10).

In the *Foreword* of the MPEP it is stated, inter alia, that it "outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application." (Emphasis added). The rejection in the subject application under Section 102(b) based upon two events, (1) a publication and (2) a foreign sale is clearly not authorized by the MPEP and should be withdrawn. As noted

previously, it is admitted in the Action that “(t)he text of the relied upon publications standing alone would not have enabled one skilled in the art to practice the claimed invention.” That admission perforce establishes the wrongfulness of using the publications as a basis for a rejection in the face of MPEP 700-10. None of the PBR publications relied upon “teach every aspect of the claim” and are clearly not a basis for a rejection under Section 102(b).

Moreover, use of combined references in a Section 102 rejection is contrary to the law as established by the Court of Appeals, Federal Circuit which has explicitly declared that: “...one who seeks such a finding (anticipation under 35 U.S.C. 102) must show that each element of the claim in issue is found, either expressly described or under principles of inherency, in a single prior reference...” (Emphasis added). Kalman v. Kimberly-Clark Corp., 713 F2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983). Thus, it is clearly improper to base the rejection of the claim of the subject application on (1) the publication of a prior breeder’s rights application and/or grant which it is admitted did not taken alone enable “one skilled in the art to practice the claimed invention” and (2) the fact that the plant of the application was offered for sale outside of the United States more than one year prior to the subject application. Only by securing a portion of the actual plant material and by an asexual process with such portion could the plant be further multiplied. Thus multiplication of the rose plant of the invention is enabled, not because of the PBR publications, but only through procurement of actual plant material and asexual reproducing the plant from such material..

To justify reliance upon the foreign sales, the Examiner argues on page 3 of the Action that “when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied on to show that the primary reference has an ‘enabled disclosure’,” citing In re Samour, 571 F2d 559, 197 USPQ 1 (CCPA 1978), and In re Donohue, 766 F2d 531, 226 USPQ 619 (Fed Cir. 1985). Neither of these citations supports the reference to a

foreign sale to justify the rejection herein. In Samour, the claims at issue were two chemical compounds rejected on a reference which disclosed the compounds but did not disclose a method of making the same. The Examiner's citation to other prior art references that disclosed a process by which the claimed compounds could be made was held proper. This is quite a different matter from the reliance herein on the non-prior art foreign sale of the rose plant of the application, from which plant additional plants could be produced by asexual reproduction. The fact of such sale and the possible awareness thereof did not make it possible for anyone to "make" such rose variety on the basis of the breeders' rights publications and other knowledge that such person had. To effect reproduction, i.e., multiplication, of the rose of the application it was and is absolutely necessary to obtain live plant material and asexually reproduce plants therefrom. The various cited breeders' rights publications and grants are totally ineffective in enabling production of the rose variety HARyup. In re Donohue, discussed previously, dealt with a situation similar to that in Samour and is not relevant to the issues presented here except its affirmation that a reference to be enabling must enable one of ordinary skill in the art "to 'make' the claimed invention." (226 USPQ at 621.)

**THE BASIS OF REJECTION HEREIN ADVANCED CONSTITUTES A REVERSAL OF
POLICY FOLLOWED FOR SEVENTY YEARS AND WILL HAVE A DEVASTATING
EFFECT UPON THE PLANT INDUSTRY IF ALLOWED TO CONTINUE**

For seventy years following the enactment of the Plant Patent Act, the plant industry relied upon the established law that a publication describing a plant was not an enabling publication that could negate the possibility of securing plant patent protection upon that variety. Not for seventy years has it ever been suggested that by the reason of the sale or otherwise making the plant publicly available in some part of the world outside of the United

States such a publication is rendered “enabling” to bar a plant patent. Without any discussion whatsoever with the plant industry, which had come to rely upon this interpretation of the law, the Patent Office sometime in the year 2000 suddenly decided that a publication describing a plant, otherwise admittedly not enabling became enabling if the plant of a plant patent application had been on sale or made publicly available outside of the United States more than one year prior to the filing date of the application. This policy, if continued, would have a devastating effect upon the plant industry and the citizenry of the United States as a whole. It will deter efforts to import new plant varieties to the United States which might prove economically beneficial to the populace as a whole and/or otherwise improve the beauty or livability of the United States.

For example, as set forth in the Amendment filed September 21, 2001, in response to the Office Action dated August 3, 2001, even the process of bringing a new ornamental rose variety into the United States and determining its adaptability to our varied climates and its commercial possibilities requires a period of about seven years and a cost of \$8,000 to \$12,000, and out of one hundred varieties brought in to the United States for consideration only two or three may warrant commercial production. A majority of these new rose varieties brought to the United States have been made the subject of PBR applications in various countries of the world and have been offered for sale in such countries before they are even brought into the United States for testing. To impose a requirement that a U.S. plant patent application has to be filed within one year of the first foreign publication and sale of a plant variety and long before its adaptability to our climates is determined would put an intolerable cost burden on the nursery industry which would inhibit the introduction of new and useful varieties of plants into the United States.

The testing period for ornamental fruit and nut bearing trees requires an even more expensive and a longer test period starting with a multi-year quarantine.

**SALE OF A PRODUCT IN A FOREIGN COUNTRY HAS NEVER BEEN HELD
TO ENABLE AN OTHERWISE NON-ENABLING DISCLOSURE OF A
MECHANICAL PRODUCT**

Imagine a publication in a foreign country offering for sale in such country a novel acoustic amplifier or a mechanical pump for pumping fluids or a million dollar computer, the publication simply describing the improved results of the apparatus without illustrating how such results are obtained. From such advertisements no one could make a reproduction of the amplifier, the pump, or the computer as the case may be. Under the theory of rejection that has been applied in this application such advertisements accompanied by the sale of the products in foreign countries would “enable” such disclosures and raise a bar to securing patent protection in the United States. No reported case has been found presenting such a factual situation, but it seems clear that such events would never sustain a rejection under 35 USC 102(b) of an application for a utility patent for such a product. The basis for rejection applied to the appealed application is equally wrong. There is no basis in the law for applying a different policy to plant patents than is applied to utility patents.

**ENABLING PUBLICATION SHOULD BE ONE THAT PUTS PUBLIC IN
PERMANENT POSSESSION OF INVENTION – NOT FOR SOME
INDETERMINATE PERIOD**

It is clear that it was the intent of the patent law that an enabling disclosure was one that permanently puts the invention in possession of the public – not for some indeterminate period of time. However, the basis of rejection herein relies upon the perpetual existence of a rose plant to place the rose plant of a publication in

possession of the public when in fact a rose plant may have only a fleeting existence. The existence of a rose variety is dependent upon its continued cultivation and maintenance and many rose varieties have gone extinct because of lack of interest in their qualities. The policy of the rejection herein thus relies upon what might be a fleeting existence of the plant of the application and should it go extinct the public could never be put back in possession of it by reason of the publications relied upon in the rejection of this application. Thus the philosophy behind the rejection herein (and in Thomson) is further flawed and should not support the rejection.

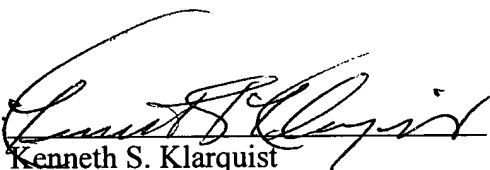
CONCLUSION

The publications relied upon in the rejection of this application are admittedly non-enabling and there is no basis in law for holding that the commercial availability outside of the United States of the plant of the application renders such references enabling. The rejection of the claim of the application under 35 USC 102(b) should be reversed and the application should be allowed.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By



Kenneth S. Klarquist
Registration No. 16,445

Attorneys for Appellant

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 226-7391
Facsimile: (503) 228-9446

IX. Appendix A
Claim On Appeal

A new and distinct variety of rose plant of the climber class, substantially as herein shown and described, characterized particularly by having good floriferousness, improved resistance to mildew and rust, vigorous growth habit suitable for a climbing rose, and a novel soft pink flower color.

X. Appendix B

TRANSCRIPT OF RECORD, filed August 17, 1960 in United States Court of
Customs and Patent Appeals, Patent Appeal Docket Nos. 6727 and 6728 In the Matter of the
Application of Edward Burton LeGrice.

TRANSCRIPT OF RECORD

**United States Court of Customs
and Patent Appeals**

PATENT APPEAL DOCKET

Nos. 6727 and 6728

**IN THE MATTER OF THE APPLICATION OF
EDWARD BURTON LeGRICE**

APPEAL FROM BOARD OF APPEALS

Serial Nos. 709,127 and 709,128

**FILED AUGUST 17, 1960
PRINTED NOV 10 1960**

INDEX

	PAGE
Petition of appeal to U. S. Court of Customs and Patent Appeals (P. A. 6727)	1
Certificate of Commissioner of Patents to record	2
Petition of appeal to U. S. Court of Customs and Patent Appeals (P. A. 6728)	3
Certificate of Commissioner of Patents to record	5
Stipulation	6

SERIAL NUMBER 709,127 (EDWARD BURTON LEGRICE)

Letter of Examiner, January 16, 1959	10
Appeal to Board of Appeals, July 7, 1959	12
Brief, September 9, 1959 (Portion)	12
Examiner's Answer, November 3, 1959	14
Decision of Board of Appeals, February 12, 1960	22
Request for Reconsideration, March 14, 1960	28
Decision of Board of Appeals, May 20, 1960	29
Notice of Appeal to United States Court of Customs and Patent Appeals, June 20, 1960	29

ION

IN THE

**United States Court of Customs
and Patent Appeals**

PATENT APPEAL

No. 6727

In Re: Application of Edward Burton LeGrice; Serial
No. 709,127; Filed: January 15, 1958; For: ROSA
FLORIBUNDA PLANT

Petition for Appeal

To the U. S. Court of Customs
and Patent Appeals:

Your petitioner, Edward Burton LeGrice, of North
Walsham, Norfolk, England, respectfully represents:

That he is the original, first developer and discoverer,
and asexual reproducer of a certain new and distinct variety
of Rosa Floribunda Plant.

That on the 15th of January, 1958, in the manner pre-
scribed by law, he presented his application to the Patent
Office, praying that a patent be issued to him for the said
plant.

That such proceedings were had in said office upon said
application; that on the 12th day of February, 1960, it was
rejected by the Board of Appeals and a patent for said
plant was refused him.

That on or about the 12th of March, 1960, your peti-
tioner filed a Request for Reconsideration of the Board's
decision of February 12, 1960; and that on the 20th of
May, 1960, the Board denied the petition.

That on the 16th day of June, 1960, your petitioner,
pursuant to sections 142 of Title 35, United States Code,
gave notice to the Commissioner of Patents of his appeal

to this honorable court from his refusal to issue a patent to him for said plant upon said application as aforesaid, and filed with him, in writing, the special reasons of appeal hereinafter included.

That the Commissioner of Patents has been requested to furnish to this court a certified transcript of the record and proceedings relating to said application for a plant, including the reasons of appeal, which transcript is to be considered as filed herewith and is to be deemed and taken as a part hereof.

Wherefore your petitioner prays that his said appeal may be heard upon and for the reasons assigned therefor to the commissioner as aforesaid, and that said appeal may be determined and the decision of the commissioner be revised and reversed, that justice may be done in the premises.

EDWARD BURTON LEGRICE

By JOHN H. LEONARD
His Attorney

SPENCER B. MICHAEL
of Smith, Michael & Gardiner
Woodward Building
Washington 5, D. C.

JHL:ff
Cleveland, Ohio
July 20, 1960

Indorsed: United States Court of Customs and Patent Appeals. Filed Aug 17 1960. Cabell N. Pryor, Clerk.

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

To all persons to whom these presents shall come,
Greeting:

THIS IS TO CERTIFY that the annexed is a true copy from the records of this office of Certain Requested Documents,

said Documents being the Record for the United States Court of Customs and Patent Appeals, in the matter of the

Pending Application of
Edward Burton LeGrice,

Filed January 15, 1958, Serial Number 709,127,

for
Rosa Floribunda Plant.

IN TESTIMONY WHEREOF I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington, this seventeenth day of August, in the year of our Lord one thousand nine hundred and sixty and of the Independence of the United States of America the one hundred and eighty-fifth.

ROBERT C. WATSON
Commissioner of Patents.

(SEAL)

ATTEST:

W. G. LANHAM JR.
Certifying Officer

IN THE
UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS

PATENT APPEAL

No. 6728

In re: Application of Edward Burton LeGrice; Serial
No. 709,128; Filed: January 15, 1958; For: ROSA
FLORIBUNDA PLANT

Petition for Appeal

To the U. S. Court of Customs
and Patent Appeals:

Your petitioner, Edward Burton LeGrice, of North
Walsham, Norfolk, England, respectfully represents:

That he is the original, first developer and discoverer, and asexual reproducer of a certain new and distinct variety of Rosa Floribunda Plant.

That on the 15th of January, 1958, in the manner prescribed by law, he presented his application to the Patent Office, praying that a patent be issued to him for the said invention.

That such proceedings were had in said office upon said application; that on the 12th day of February, 1960, it was rejected by the Board of Appeals and a patent for said plant was refused him.

That on or about the 12th of March, 1960, your petitioner filed a Request for Reconsideration of the Board's decision of February 12, 1960; and that on the 20th of May, 1960, the Board denied the petition.

That on the 16th day of June, 1960, your petitioner, pursuant to sections 142 of Title 35, United States Code, gave notice to the Commissioner of Patents of his appeal to this honorable court from his refusal to issue a patent to him for said plant upon said application as aforesaid, and filed with him, in writing, the special reasons of appeal hereinafter included.

That the Commissioner of Patents has been requested to furnish to this court a certified transcript of the record and proceedings relating to said application for a plant, including the reasons of appeal, which transcript is to be considered as filed herewith and is to be deemed and taken as a part hereof.

Wherefore your petitioner prays that his said appeal may be heard upon and for the reasons assigned therefor to the commissioner as aforesaid, and that said appeal may be determined and the decision of the commissioner be revised and reversed, that justice may be done in the premises.

EDWARD BURTON LEGRICE

By JOHN H. LEONARD
His Attorney

SPENCER B. MICHAEL
of Smith, Michael & Gardiner
Woodward Building
Washington 5, D. C.

JHL:ff
Cleveland, Ohio
July 20, 1960

Indorsed United States Court of Customs and Patent
Appeals. Filed Aug 17 1960. Cabell N. Pryor, Clerk.

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

To all persons to whom these presents shall come,
Greeting:

THIS IS TO CERTIFY that the annexed is a true copy from
the records of this office of Certain Requested Documents,
said Documents being the Record for the United States
Court of Customs and Patent Appeals, in the matter of the

Pending Application of
Edward Burton LeGrice,

Filed January 15, 1958, Serial Number 709,128,

for
Rosa Floribunda Plant.

IN TESTIMONY WHEREOF I have hereunto set my hand and
caused the seal of the Patent Office to be affixed at the City
of Washington, this seventeenth day of August, in the year
of our Lord one thousand nine hundred and sixty and of
the Independence of the United States of America the one
hundred and eighty-fifth.

ROBERT C. WATSON
Commissioner of Patents.

(SEAL)

ATTEST:

W. G. LANHAM JR.
Certifying Officer

IN THE
UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS

PATENT APPEAL NOS. 6727, 6728

In re Applications of Edward Burton LeGrice; Serial Nos.
709,127 and 709,128; Each filed: January 15, 1958; Each
For: ROSA FLORIBUNDA PLANT

To the U. S. Court of Customs
and Patent Appeals:

Stipulation

The Commissioner of Patents and Edward Burton LeGrice, the Appellant-Applicant in the above entitled appeals, by their attorneys, hereby stipulate and agree as follows, the Honorable Court consenting:

1. Appeal Nos. 269-46 and 269-47, before the Board of Appeals, be combined for proceedings before this court.

The facts in the cases on appeal are as follows:

2. The Appellant, Edward Burton LeGrice, on January 15, 1958, filed applications for plant patents, as follows:

(a) Serial No. 709,127, which became Appeal No. 269-47 before the Board of Appeals; and

(b) Serial No. 709,128, which became Appeal No. 269-46 before the Board of Appeals.

3. Each application included a conventional plant patent claim reading as follows:

-- A new and distinct variety of rosa floribunda plant herein shown and described. --

4. Each application was accompanied by the conventional formal oath containing the statement that the applicant did not believe the variety of plant was described in any printed publication in any country more than one year prior to his application, but adding the following additional recitations:

(a) In Serial No. 709,127, --

"that certain information relative to the new variety was published in the National Rose Society Annual, of England, for 1954 on pages 156 and 157 and like information was published more than one year prior to the date hereof in catalogues, but he believes that such information cannot enable anyone to practice the invention by producing the present variety."; and

(b) In Serial No. 709,128, --

"that certain information relative to a new variety was published in the National Rose Society Annual, of England, in 1949 on page 155, and like information was published more than one year prior the date hereof in catalogues, but he believes that such information cannot enable anyone to practice the invention by producing the variety".

5. (a) The disclosures in the Rose Annual of 1949, page 155, insofar as pertinent, is as follows:

"The Gold Medal Award was made to: --

(Here follows the list of roses, including Dusky Maiden) ---

--- Dusky Maiden (Hy. Poly.) raised and exhibited by E. B. LeGrice, North Walsham. -- Glowing dark scarlet with dusky velvety sheen. Single blooms carried in large trusses. Size when open 3-in. in diameter. Very fragrant. Vigorous. Foliage dark green and abundant. Bedding. Trial Ground Certificate, 1945. Prune 34."

(b) The disclosure in the Rose Annual of 1954, pages 156 and 157, is as follows:

"The Trial Ground

LIST OF TRIAL GROUND AWARDS, 1953

(To which is appended the Show Awards in 1953.)

(Here follows a list of roses, including Charming Maid) ---

--- Charming Maid (Flor.). Trial Ground No. 624. Reg. No. 269. Dainty Maiden x Mrs. Sam McGredy. Raiser and Distributor E. B. LeGrice, North Walsham. Vigorous growing variety with deep glossy green foliage 16. Freedom from disease 16. Large single flowers borne in small clusters. Colour pink shaded gold 16. Freedom of flowering 16. General effect 6. Fragrance 5. Gold Medal Provincial Show, 1953."

6. In each case, the prior catalogue publication referred to in the oath includes a color picture of the rose clear enough to establish identity in appearance between the rose illustrated and the applicant's variety, and the catalogue publication with the picture establishes that the rose described and illustrated is the variety described and claimed in the application, and the rose so described and illustrated is, in fact, the variety so described and claimed in the application.

7. Insofar as concerns the issues herein, the Examiner's actions, Applicant's responses, the Final rejection, the Appeal to the Board of Appeals, the Examiner's statement, the Decision by the Board of Appeals, the Request for Reconsideration, the Decision by the Board (on reconsideration), and the Notice of Appeal to this Court, are identical in the two cases.

8. The specifications as filed, and amendments thereto, the drawing, the rejected claim, and the publications referred to in the oaths, other than the recitations from said publications, are unnecessary to the determination of the issues herein and shall be omitted from the printed record.

9. The statutes from 35 U. S. Code, referred to herein, insofar as pertinent, are as follows:

Sect. 102: "A person shall be entitled to a patent unless ---

--- (b) the invention was patented or described in a printed publication in this or a foreign country more

than one year prior to the date of the application for patent in the U. S. ---

Sect. 112: "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains ---- to make and use the same."

Sect. 161, second paragraph: "The provisions of this title relating to patents for inventions shall apply to plants, except as otherwise provided."

Sect. 162: "No plant patent shall be declared invalid for non-compliance of Sect. 112 of this title if the description is as complete as is reasonably possible."

10. As to papers from the prosecution files to be included in the printed record, only those from Ser. No. 709,127 shall be used, and shall be considered the record for both cases, and the decision of this Court based thereon shall apply fully to both applications.

11. The entire record shall consist of the following papers, from application Ser. No. 709,127:—

- a. Final Rejection, dated January 16, 1959, Paper No. 6, (erroneously numbered Paper No. 7).
- b. Appeal to Board of Appeals (Paper No. 9).
- c. Brief on Behalf of Applicant on Appeal, Paper No. 10, pages 1, 2, and 3 down to the heading "*The Errors*". (This portion was incorporated by reference in the Examiner's Answer, page 2, next to last paragraph).
- d. Examiner's Answer (Paper No. 11).
- e. Decision by the Board of Appeals (Paper No. 15).
- f. Request for Reconsideration (Paper No. 16).
- g. Decision by Board on Reconsideration (Paper No. 17).

- h. Notice of Appeal to this Court (Paper No. 18).
- i. This Stipulation.

Date 8/9/60

C. W. MOORE
For the Commissioner of Patents

Date 8/8/60

JOHN H. LEONARD
Attorney for Appellant-Applicant

Indorsed: United States Court of Customs and Patent Appeals. Filed Aug 25 1960. Cabell N. Pryor, Clerk.

Approved by Court:

Date 9/28/60

EUGENE WORLEY
Chief Judge

12 Letter of Examiner, January 16, 1959

Responsive to letter of December 8, 1958.

Applicant's extensive argument regarding the question raised in the previous office action concerning the publication referred to by him in his oath as constituting a Statutory bar to the issuance of a plant patent to him has been carefully considered.

Applicant in his oath refers to the publication of the National Rose Society Annual of England for 1954, pages 156 and 157 and to "Catalogues" published more than one year prior to January 15, 1958, the filing date of this application. In response to the requirement that he submit copies of these publications, applicant has submitted only a copy of the National Rose Society publication and none as to the "catalogues".

The statement in the oath that the information in the publications mentioned therein

"cannot enable anyone to practice the invention by producing the present variety"

is, in spite of applicant's argument upholding this view, not considered relevant to the issue herein presented as to said publication barring the grant of a plant patent.

13 However, in passing it is observed (bearing this statement in mind) that in spite of the provisions of 35 U. S. C. 161, second paragraph and 35 U. S. C. 112, first paragraph, it is humanly impossible "to make" a plant variety as described in a publication or in a plant patent. This fact, so altogether obvious, can neither affect the use of a publication under 35 U. S. C. 102 (b) as a statutory bar nor the validity of a plant patent itself. Be this as it may, insofar as 35 U. S. C., 102(b) can be applied to plant patents, the language of the statute that:

"A person shall be entitled to a patent unless (b) the invention was patented or described in a printed publication -----, more than one year prior to the date of the application for patent in the United States",

must be taken in its exact and unequivocal meaning.

Accordingly, under the statute 35 U. S. C., 102(b), it is held that both the National Rose Society publication and the catalogues referred to by applicant in his oath, establishes that applicant's plant variety was described in a printed publication "more than one year prior to the date" of the instant application. These publications in the language of the statute constitute a statutory bar and preclude the patenting of his plant variety. While applicant has not submitted copies of the catalogues, yet in view of his own statement in his oath, it must be presumed that the information in the catalogues is sufficient to establish identity between the plant variety disclosed therein and that of the instant application.

This application is rejected, applicant being barred under 35 U. S. C. 102(b) from obtaining a patent thereon, and under Rule 113, this rejection is hereby made Final.

FINAL REJECTION.

A. JOSEPH GOLDBERG
Examiner

12

APPLICATION OF EDWARD BURTON LEGRICE

14 **Appeal to Board of Appeals, July 7, 1959**

The Commissioner of Patents
Washington 25, D. C.

Sir:

Applicant hereby appeals to the Board of Appeals from the decision of the principal examiner finally rejecting the claim in the above entitled application.

The Appeal Fee of \$25.00 is enclosed herewith by Check No. 7161 of John H. Leonard.

Respectfully submitted,

EDWARD BURTON LE GRICE

By JOHN H. LEONARD
John H. Leonard, Attorney

15

**Brief, September 9, 1959
(Portion)**

This is an appeal from the decision of the Principal Examiner finally rejecting the claim in the above entitled application for a plant patent having the single conventional claim, reading as follows:

“The new and distinct variety of Rosa Floribunda plant herein shown and described.”

The formalities of the claim are not in issue.

The board issue involved in this appeal is, as stated by the Examiner, the interpretation to be placed on the words “printed publication” as it appears in the United States statute 35 U. S. C. 102 (b) that

“A person shall be entitled to a patent unless ---
(b) the invention was patented or described in a printed publication ---, more than one year prior to the date of the application for patent in the United States, ---.”

How the Issue Arose

The applicant filed his application on January 15, 1958, including the conventional formal oath, executed December 31, 1957, qualified by reciting

"certain information relative to the new variety was published in the National Rose Society Annual of England for 1954 on pages 156 and 157, and like information was published more than one year prior to the date hereof in catalogues, but he believes that such information cannot enable anyone to practice the invention by producing the present variety."

16 The Examiner in the Office Action Paper No. 4 quoted this wording of the Oath and requested copies of the subject matter shown in the publications and rejected the application as being contrary to 35 U. S. C. 102 (b).

The Examiner held that whether the information would enable anyone to practice the invention was "immaterial if the publications or catalogues referred to do in fact describe Applicant's invention (the present variety)."

The applicant then responded by pointing out that the wording referred to was as follows:

"The Trial Ground

LIST OF TRIAL GROUND AWARDS, 1953

(To which is appended the Show Awards in 1953.)

• • • (here follows a list of roses, including the following reference to the rose plant of this application) • • •

Charming Maid (Flor.). Trial Ground No. 624, Reg. No. 269. Dainty Maiden x Mrs. Sam McGredy. Raiser and Distributor E. B. Le Grice, North Walsham. Vigorous growing variety with deep glossy green foliage 16. Freedom from disease 16. Large single flowers borne in small clusters. Colour pink shaded gold 16. Freedom of flowering 16. General effect 6. Fragrance 5. Gold Medal Provincial Show, 1953."

The applicant argued why the interpretation of the statute, as applied to plant patents, must be the same as applied to mechanical patents and, when so applied, the published information did not enable one to practice the invention.

The Examiner held that the above quoted language of the statute must be taken "in its exact and unequivocal meaning", and finally rejected the application.

The applicant requested reconsideration, which was granted, and after written argument, the Examiner held "that the applicant's discussion regarding the meaning to be given the words 'printed publication', in so far as it applies to plants is deemed academic and does not in any way establish that the words 'printed publication' as it relates to plants can mean anything else but what
17 the statute explicitly specifies and that is a 'printed publication'." The Examiner then held the printed publications referred to were within the full intent of the statute and thereupon affirmed the final rejection.

Respectfully submitted,

EDWARD BURTON LE GRICE

By JOHN H. LEONARD
His Attorney

September 8, 1959
Cleveland, Ohio

18 **Examiner's Answer, November 3, 1959**

This is an appeal in an application for a plant patent on a Rosa Floribunda Plant from the final rejection of the single claim therein based on printed publications describing appellant's identical plant variety and having effective dates more than one year prior to the filing date of this application, which publications constitute under 35 U. S. C. 102(b) a statutory bar to the grant of a patent on appellant's variety of Rosa Floribunda Plant.

The single claim is correctly set forth in appellant's brief. The printed publications relied on for the statutory bar are:

(1)- The National Rose Society Annual, of England, for 1954, pages 156 and 157. (A photocopy of these pages is attached to Paper No. 5).

(2)- Catalogues.

Information as to these publications was given by appellant in his oath and is correctly quoted at the bottom of page 1 of his brief.

19 In the second Office action, Paper No. 4 appellant was required to submit copies of both pages 156 and 157 of the Rose Society Annual and the catalogues.

With regard to the required "catalogues", appellant in his brief, page 23, states:

"The attorney for the applicant does not have available complete copies of the catalogues mentioned but is seeking to obtain the same from the applicant. The particular catalogue in the present instance showed a color picture of the rose which was clear enough to *establish identity in appearance between the catalogue and the applicant's variety. In any event it can be taken that they add to the information in the Rose Annual a reproduction in color of a color photograph of the variety.*" (Emphasis added by Examiner).

As to these publications, it is apparent from the above that the extent or sufficiency of their disclosure is not in issue.

The broad issue involved in this appeal and how the issue arose is correctly set forth on pages 1, 2 and 3 of appellant's brief.

The principal errors complained of as listed by the appellant, page 3 of his brief are as follows:

(1) The Examiner has misinterpreted the statute as applied to plant patents.

- (2) The Examiner, in order to reject the application, has interpreted the statute in the case of plant patents differently from the long established interpretation in the case of mechanical and article patents.
- 20 (3) The Examiner applied the statute in what the Examiner believed to be its exact and unequivocal meaning.
- (4) The Examiner, having made this ruling, then does not interpret the statute in its correct, true and unequivocal meaning.

Appellant in great detail has discussed the history and intent of the plant patent law, and has compared and given his interpretation of the statute 35 U. S. C. 102(b) regarding a "printed publication", as it relates to the law of utility patents and of plant patents.

Appellant is correct in stating, page 3 of his brief that

"The intent of the plant patent law is so intertwined with the earlier law of mechanical patents that the former cannot be understood and appreciated without an understanding of the intent of the latter."

This statement is in fact supported in the present Plant Patent statute 35 U. S. C. 161, 2nd paragraph which states:

"The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided."

Appellant in his argument has properly stated the law as it interprets "printed publication" in the statute, (see brief, page 6) that:

- 21 "to bar a patent, a description in a printed publication, more than a stated period prior to the filing date of an application, must be a description which would enable one to practice the invention and produce the final res."

Also pointing out, (see brief, page 9) that:

"The teaching in plant patent cases or a plant prior publication cannot enable anyone, even the most skillful of plant breeders, to produce the particular plant."

and concluding, (see brief, page 10)

"Accordingly, the basis for refusing a plant patent on a printed publication becomes totally illogical and invalid, and contravenes the entire intent of the patent laws."

"The basis is invalid because the publication cannot possibly have the enabling characteristics which the law requires, ---."

With the added statement, (see brief, page 12) that:

"It might be said that on this basis, no prior publication "disclosing" a plant can defeat the plant patent. If "disclosure" means ----- an *enabling* disclosure, this statement is true, and it is good that it should be."

Appellant's interpretation as explained by him thus establishes the premise that insofar as an application for a plant patent is concerned a printed publication filed more than a year before the filing of said application cannot constitute a bar to the grant of a plant patent. However the fact remains that the statute 35 U. S. C. 102(b) specifically states:—

"A person shall be entitled to a patent unless—

- 22 (b) the invention was patented or described in a printed publication in this or a foreign country ---, more than one year prior to the date of the application for patent in The United States, ---"

There is no distinction or exception made in the statute with regard to applications for plant patents, and Chapter 15

—Plant Patents of the U. S. Code, Title 35—Patents—shows that the plant patent statutes, sections 161-164 make no provision regarding the bar of a printed publication to the grant of a plant patent, it being again noted that Section 161, 2nd paragraph states:

“The provision of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.”

As it is obvious that no special provision has been made in the plant patent statutes concerning a “printed publication”, the provisions of 35 U. S. C. 102(b) cannot be taken both in their entirety and as interpreted by the Courts. Thus, on the one hand the Courts, see page 7 of brief, have interpreted that the “printed publication” of the statute in order to be valid must have an enabling disclosure and on the other hand as appellant argues, a printed publication of a plant cannot constitute an enabling disclosure and is therefore not valid, as quoting from appellant’s oath “such information cannot enable anyone to practice the invention by producing the present variety.” This anomaly of a plant publication gives rise to the question as to what then is the proper action with regard thereto?

23 If a plant publication is to be considered not a publication within the meaning of the statute then the proviso in 35 U. S. C. 102(b) as to printed publications must be totally ignored. However with no statutory directive nor precedent it would seem that the Examiner had no alternative but to follow the language of the statute, and as stated in the final rejection, Paper No. 6, page 2, such language “*must be taken in its exact and unequivocal meaning.*” This means simply that (quoting 35 U. S. C. 102(b)):

“A person shall be entitled to a patent unless—

The invention was — — — described in a printed publication — — —, more than one year prior to the

date of the application for patent in The United States, - - - - -."

By this statement in the Final rejection that the language of the statute "must be taken in its exact and unequivocal meaning" the Examiner simply accepts the language of the statute as it stands and without interpretation. If a printed publication is in evidence and the plant variety is disclosed therein and if it has an effective date more than one year prior to the filing date of an application in The United States on the same variety than the applicant is *not entitled* to a patent.

Then again, such a printed publication as prior art may well establish that a plant variety is not new and distinct. For example, a publication may be 25 years old and discloses and describes a certain type of plant A, which
24 was on sale and well known at that time. Later this type of plant A was superseded by an improved type of plant B with greater appeal. Many years later an application was filed on a plant A¹ which the publication showed to be one and the same as that in the application. There is no evidence that the plant A of the publication is actually extinct, it being merely known in the trade to be no longer on the market. Thus, the publication certainly negatives patentable novelty and precludes the grant of a patent under 35 U. S. C. 161 as it establishes the plant variety A¹ to be not a "distinct and new variety", the publication further barring the grant of a patent under 35 U. S. C. 102(b). Accordingly, based on the argument advanced by appellant, that a printed publication is not valid because it is not an enabling disclosure a patent should therefore be granted on the plant A¹. This does not seem proper.

The uniqueness of a plant patent which in itself is not an enabling disclosure, and the paucity of judicial precedent in plant patent matters requires great care on the part of the Examiner in applying the plant patent statutes and rules in the examination of applications for plant patents,

and certainly the issue herein involved is paradoxical to say the least.

The publications referred to in appellant's oath forming part of this application describe and identify the rose plant and it is emphasized the sufficiency of the disclosure is *not* in issue. Appellant's argument that a plant publication cannot bar the grant of a plant patent even if accepted by the Examiner cannot warrant the Examiner in ignoring the specific provision in the statute (35 U. S. C. 102(b) as to a printed publication. It is not seen that a plant publication completely disclosing and describing a plant and of sufficient age can be said to be *not a publication* within the meaning of the statute because it is

and not an enabling disclosure as argued by appellant; / who can say with utter positiveness that a similar plant could not be developed or even discovered from a disclosure made in a plant publication. The independent discovery of separate sports or effecting of mutations by manipulative treatment of a plant by means of chemicals, X-rays, atomic isotopes, etc. may produce identical plants. This may be remote but it is possible. In *Kim Bros. v. Hagler* 120 U. S. P. Q. 210, at page 214 appears the following interrogatory:

"Q. Am I correct that if a nectarine was a mutation that it would be extremely remote, if not impossible, to be the same plant patent No. 974? A. Yes, you are wholly correct.

"Q. So, in other words, the chance of a mutation having all the characteristics of your plant patent 974 is impossible, or could we go that far? A. It is going very far.

"The Court: I presume 'remote' would be a better word.

26 "The Witness: Yes, extremely remote. *It has never happened in the history of horticulture, but that is not saying that it couldn't be some place.*" (Emphasis added)".

Robert Starr Allyn in his book "The First Plant Patents" (Copy in Division 1), Chapter 35 —publication—, page 40 states:

"Description in a printed publication more than two years before filing an application is fatal but considerable question is probably open as to what kind of a description of a plant will apply. If it is not necessary to describe the method of production of the new plant in the patent, it would appear that a mere disclosure of the characteristics of the plant in a printed publication more than two years before the application would be fatal."

Apropos to the issue herein, Allyn in his book Chapter 61 —Conclusion—, page 57 states that:

"The history of the Act shows that it was thrown together hastily and practically no thought given to many of the basic problems involved."

which comment directs attention to that made by appellant, page 3 of his brief, that:

"The decision arrived at herein can have a profound influence on the plant patent law for years to come, either directly by establishing a judicial precedent or indirectly by influencing remedial legislation."

In view of the circumstances in the instant case, the Examiner on the arguments advanced by the appellant before him could not take unto himself to nullify the provisions as to a "printed publication" in 35 U. S. C. 102(b),
27 and for the reasons given both in the Final Rejection, Paper No. 6, and in the subsequent Office letter, Paper No. 8, the holding that the designated publications constitute a statutory bar to the grant of a plant patent is considered proper and should be sustained.

Respectfully submitted,

A. JOSEPH GOLDBERG

Examiner, Division 1

28 Decision of Board of Appeals, February 12, 1960

The above identified applications involving the identical legal question are being considered simultaneously on appeal. Each is an application for a plant patent having the customary single formal claim which in each case is directed to an assertedly new variety of rose plant.

In each case descriptions of the plant have appeared in printed publications more than one year prior to the filing of the applications. These have appeared, for one case,

in The National Rose Society Annual of England
29 for 1949 and for the other case in The National Rose Society Annual of England for 1954 (the applications

were filed in 1958). Photocopies of pages of these Annuals are of record. In each case there are also catalogues published more than one year prior to the dates of the respective applications. The catalogues have not been made available but are admitted, pages 24 and 23 of the respective briefs, to "add to the information in the Rose Annual a reproduction in color of a color photograph of the variety."

In a paper filed November 19, 1959 in Appeal No. 269-46 requesting consolidation of the two appeals, appellant conceded that "the publications are thoroughly adequate in each instance to identify the plant as the plant in the particular application." A similar statement appears on page 3 in each of the reply briefs.

It may be noted that the various publications were acknowledged by appellant in the oaths accompanying the applications.

The publications indicate that the particular plants were on sale, and presumably also in public use, more than one year prior to the respective filing dates of the applications since appellant is indicated as "raiser and distributor." However this question is not in issue since the public use or sale must be in the United States in order to bar a patent and these events, as far as anything suggested by the record is concerned, took place in England. The single broad issue of the competency of a prior printed publication to bar a plant patent is presented.

30 The examiner has rejected the claim in each case on the ground that the printed publications having effective dates more than one year prior to the filing dates of the instant applications constitute statutory bars to the grant of patents on the described varieties of rose plants. The applicable portion of 35 U. S. C. 102(b) reads:

"A person shall be entitled to a patent unless—

* * *

(b) the invention was . . . described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States, . . ."

The examiner held the above provision applicable to plant patents in view of Chapter 15—Plant Patents of the U. S. Code Title 35—Patents, which in section 161 states:

"The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided."

Appellant (bottom of page 13 of brief) recognizes that the plant patent act was "engrafted onto the existing patent laws" and their provisions, except for "greater liberality in the completeness of the disclosure," made applicable to plants. He states:

"There was no intent to change the meaning of the wording such as now included in the quoted paragraph 102 (b), as theretofore applied to patents on articles, machines, methods, and the like. There is no evidence that it was intended that these words were to be interpreted differently in connection with plants."

It is evident from the preceding that appellant does not challenge the point so vigorously stressed by the examiner, namely the applicability of 35 U. S. C. 102(b) to plant patents. The premise of this appeal is simply that a publication describing a plant cannot, no matter how

31 complete, enable anyone to practice the invention (produce the plant); consequently such publication can never bar a plant patent under 35 U. S. C. 102(b). This result is said to follow from a consideration of the standard applied in patents for inventions, namely that in order to defeat such patents the printed publication advanced as a bar must be sufficient to enable one skilled in the particular art concerned to practice the invention, i.e., to produce the final useful result; *Wisconsin Alumni Research Foundation v. George A. Breon & Co.*, 30 USPQ 242, 85 F. (2d) 166, CCA 8 (1936); *Dewey & Almy Chemical Co. v. Mimex Co., Inc.*, 52 USPQ 138, 124 F. (2d) 986, CCA 2 (1942); or knowledge of the article describing would teach a skillful mechanic some process of making it; *Cohn v. Corset Co.*, 93 U. S. 366, 23 L. Ed. 907 (1876); *In re Schaeffer*, 2 App. D. C. 1, 8 (1893). Since neither of these requirements is met by a published description of a plant it is contended such publication must by application of the same standard be held insufficient to bar the grant of a patent on the plant.

The examiner, while not seriously challenging the appellant's premise that a plant description cannot enable anyone to produce the plant (nor do we see any reason for questioning this premise), states that the language of the statute must be taken in its exact and unequivocal meaning otherwise the anomaly arises that plant publications must be totally ignored as printed publications. In fact, it would have the effect of wholly eliminating that particular provision from 35 U. S. C. 102(b) in the case of plant patents. The examiner further maintains that a prior description of an existing plant adequate to identify the plant
32 claimed would negative patentable novelty as not "a distinct and new variety" (35 U. S. C. 161).

As indicated by his reply brief the most that appellant would concede with respect to the effect of such publication is that it might constitute secondary evidence of the *prior existence* of the actual plant and *sale* thereof so as to constitute a statutory bar. He further suggests that this

secondary evidence could almost be accepted with little or no corroboration because the chances of any fraud on the public are extremely remote. As has been stated the use or sale of the plants in a foreign country would be irrelevant.

Appellant contends it is absurd to hold that in one case (mechanical) a disclosure must be an enabling disclosure while in another (plant) it need not be. The examiner's "strict literal interpretation" above is (page 13 of brief) alleged to defeat the intent of the plant patent law which is to reward practical results and perpetuate the thing patented after expiration of the patent. Since no one could produce the plant from a written description it is alleged that this result can be assured only by grant of a patent which in turn would encourage the inventor to distribute the plant widely and thereby minimize the possibility of its loss or destruction. With respect to the remark concerning absurdity, it is no more absurd to use a disclosure which is not enabling as a bar than it is to grant a patent on such a disclosure; the disclosure in the specifications of these applications are admittedly just as unenabling as the disclosures of the publications as page 9 of the brief states that:

33 "The teaching in plant patent cases . . . cannot enable anyone, even the most skillful of plant breeders, to produce the particular plant."

Upon consideration of the issue here presented we have come to the conclusion that the examiner must be sustained. Concerning the alleged need for an enabling disclosure to constitute an anticipation, we direct attention to the fact that in the case of claims to an article (or compound), which a claim for a plant is admitted (page 8 of brief) to be most nearly like, disclosure of an operative method of making such article is not essential to constitute an anticipation. On this point we think appellant has misinterpreted the case law. *Cohn v. U. S. Corset Co.*, *supra*, relied upon by appellant did not require in the reference a

teaching of how to make the article. The Court of Appeals of the District of Columbia in the later decision *In re Decker*, 1911 C. D. 274, 162 O. G. 999, 36 App. D. C. 104, quoted *Cohn v. U. S. Corset Co.* as authority for the proposition that the inoperativeness of the reference procedure was immaterial to a consideration of the patentability of the article. A complete description of the article in the reference was held to be all that was required to defeat claims to such article. This ruling was followed in *In re Marden & Rentschler*, 18 CCPA 1119, 1931 C. D. 334, 409 O. G. 561, 48 F. (2d) 428, 8 USPQ 515, in an application involving claims for a ductible thorium wire.

That this principle remains controlling law will be evident from the more recent decisions. See for example *In re Attwood*, 45 CCPA 824, 1958 C. D. 204, 730 O. G. 790, 253 F. (2d) 234, 117 USPQ 184, involving claims to U-shaped metallic channel member as a concrete insert.

34 The Court of Customs & Patent Appeals there stated:

"... it is well settled that where the article claimed is disclosed in a prior patent, the claim may be rejected on that patent notwithstanding the fact that the process by which the patentee claimed the product could be produced is inoperative. *In re Marden and Rentschler*, 18 C. C. P. A. (Patents) 1119, 48 F. 2d 428, 8 U. S. Pat. Q. 515; *In re Von Bramer et al.*, 29 C. C. P. A. (Patents) 1018, 1024, 127 F. 2d 149, 53 USPQ 345. Clearly, appellant can stand in no better position where the patentee discloses no process for making the article claimed or where appellant can not discern from the patent disclosure how to construct the article as disclosed."

In *In re Crosley et al.*, 34 CCPA 882, 1947 C. D. 216, 600 O. G. 172, 159 F. (2d) 735, 72 USPQ 499, the same court stated:

"Furthermore, this court is committed to the doctrine that where a product is clearly disclosed in a

publication, the operativeness of any of the processes by which it is claimed the product could be produced is immaterial, and that the disclosure of the composition is sufficient to anticipate a claim therefor."

The U. S. Court of Appeals, District of Columbia Circuit still follows the same rule. See for example *Merck & Co., Inc. v. Marzall*, 1952 C. D. 35, 661 O. G. 576, 197 F. (2d) 206, 93 USPQ 355, wherein this court stated:

"We are dealing solely with an application for a patent on the compound itself. Such an application must be denied if there has been any prior disclosure of the compound, even though no practical means for its isolation or manufacture was previously known. R. S. 4886, 35 U. S. C. § 31; *Eastman Kodak Co. v. Coe*, 78 U. S. App. D. C. 403, 135 F. (2d) 836."

Since appellant has admitted that the reference publications in these cases adequately identify the claimed plants it follows from these holdings that the appealed claims were properly rejected regardless of the question of sufficiency of the reference disclosures as to how to produce the plants. The decisions demonstrate that there is no inconsistency in this instance between what properly constitutes a publication under 35 U. S. C. 102(b) in mechanical cases (patents for inventions) and the examiner's application of the references to the claims in the instant plant patent cases.

The decision of the examiner is affirmed.

AFFIRMED

L. P. McCANN)
Examiner-in-Chief)

P. J. FEDERICO)
Examiner-in-Chief)

N. A. ASP)
Examiner-in-Chief)

BOARD
OF
APPEALS

36 Request for Reconsideration, March 14, 1960

The Appellant in the above entitled Appeal, hereby requests reconsideration and reversal of the decision of February 12, 1960 of the Board for the following reasons:-

The Board erred:

1. In affirming the Examiner.
2. In holding that the decisions demonstrate there is no inconsistency in this instance between what properly constitutes a publication under Sec. 102(b) in mechanical cases and the Examiner's references to the claims in the instant plant patent cases.
3. In misinterpreting 35 United States Code, Secs. 102(b) and 112 and holding that the former should be taken in its exact and unequivocal meaning, which is contrary to the legislative intent as indicated in Sec. 162.
4. In holding, impliedly, that the granting of a plant patent on a non-enabling disclosure in an application is indicative that a non-enabling disclosure should be adequate for anticipation, whereas the former is a specific exception in the statute and the latter is not.
5. In holding that the Appellant's interpretation of the law, as presented in the Brief on Appeal, is a misinterpretation of the law and of the cases cited by the Appellant.
- 37 6. In holding that the decisions relied on by the Board are contrary to the Appellant's interpretation of the law and that a complete description of an article in a reference is all that is required to defeat claims to the article, even though there is no known way of making the article.
7. In partially misconstruing the Appellant's contention as to the nature of a publication required for anticipation under the patent laws.

A brief in support of the request for reconsideration is submitted herewith.

Reconsideration on the Brief, without oral hearing, is requested.

Respectfully submitted,

EDWARD BURTON LEGRICE

By JOHN H. LEONARD
John H. Leonard, Attorney

Cleveland, Ohio
March 11, 1960

59 **Decision of Board of Appeals, May 20, 1960**

A request for reconsideration of our decision of February 12, 1960 has been presented.

In the main it is a re-argument of the point in issue which received thorough consideration in our opinion. We find nothing in the request which convinces us of any error in our conclusion.

60 The petition has been considered but is denied in respect to making any change in our decision.

P. J. FEDERICO)	
Examiner-in-Chief)	
L. P. McCANN)	BOARD
Examiner-in-Chief)	OF
	APPEALS
N. A. ASP)	
Examiner-in-Chief)	

61 **Notice of Appeal to United States Court of
Customs and Patent Appeals, June 20, 1960**

To the Commissioner of Patents
Washington 25, D. C.

Sir:

You are hereby notified of my appeal to the U. S. Court of Customs and Patents Appeals from the decision of the Board of Appeals, rendered on or about the 12th day of

February, 1960, rejecting my above-entitled application and refusing me a patent for the invention set forth therein.

A Petition for Reconsideration was filed on or about March 12, 1960, which petition for reconsideration was refused on or about May 20, 1960.

The following are assigned as reasons of appeal:

The Board erred:-

1. In affirming the Examiner.
2. In misinterpreting 35 United States Code, Section 102(b) as applied to plant patents.
3. In rejecting the application on the interpretation of the above statute in the case of plant patents differently from the long established interpretation of the wording thereof in the case of mechanical and article patents.
4. In applying the statute in what the Examiner held to be its exact and unequivocal meaning.
- 62 5. In holding, in rejecting the request for reconsideration of its decision, that the decisions demonstrate there is no inconsistency between what properly constitutes a publication under Section 102(b) in mechanical cases and what constitutes a publication under Section 102(b) in the case of the present plant application.
6. In misinterpreting 35 United States Code, Sections 102(b) and 112, and holding that the former should be taken in its exact and unequivocal meaning, despite the exception made to Section 112 by Section 162, which latter expresses a legislative intent in case of plant patents, to liberalize the meaning of the wording in Sections 102(b) and 112 as compared to that in the case of mechanical patents.
7. In holding, impliedly, that the granting of a plant patent on a non-enabling disclosure in an application is indicative that a non-enabling disclosure should be adequate for anticipation, whereas the former is based on a specific exception made in the statute and the latter is not.
8. In holding that the applicant's interpretation of the law as established by court decisions is in error and is a misinterpretation of the decisions.

9. In holding that the decisions relied on by the Board are contrary to the appellant's interpretation of the law and that a complete description of an article in a reference is all that is required to defeat claims to the article, even though there was no known way of making the article in the reference.

10. In partially misconstruing the appellant's contention as to the nature of a publication required for anticipation under the patent laws.

Respectfully submitted,

EDWARD BURTON LEGRICE

By JOHN H. LEONARD
John H. Leonard, Attorney

Cleveland, Ohio
June 16, 1960

United States Court of Customs and Patent Appeals

Patent Appeal Docket

Nos. 6727 and 6728

IN THE MATTER OF THE APPLICATIONS OF
EDWARD BURTON LEGRICE

APPEAL FROM BOARD OF APPEALS OF
UNITED STATES PATENT OFFICE

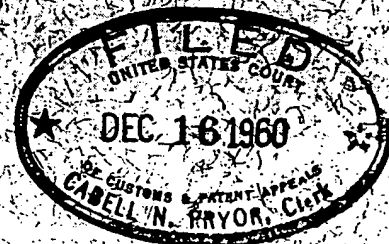
Serial Nos. 709,127 and 709,128

BRIEF OF APPELLANT

JOHN H. LEONARD,
Attorney for Appellant,
1562 Hanna Building,
Cleveland 15, Ohio.

Of Counsel:

SPENCER B. MICHAEL
of Smith, Michael & Gardiner,
Woodward Building,
Washington 6, D. C.



SUBJECT INDEX.

	PAGE
I. Statement of Case	1
II. The Errors	2
III. The Broad Issue	3
IV. Brief Statement of Appellant's Case	4
V. Basic Aspects of the Patent Statutes	6
VI. The Problems Posed by the Inherent Differences in Plants and Man Made Articles	7
VII. The Solution of the Problem	9
VIII. The Error in Misinterpreting 35 U. S. Code, Sect. 102-B and 112 and Holding that the Words "Described in the Printed Publication" Should be Taken in Their "Exact and Unequivocal Meaning" When Applying the Statute to Plant Patents	10
IX. The Law Should Encourage Prompt Printed Disclosures of New Varieties of Plants	13
X. Congress Did Not Intend Any Change in the Established Meaning of the Words.....	14
XI. The Case Law	15
XII. Discussion of Cases Cited by the Board	16
XIII. The Dangers Inherent in the Board's Interpretation of the Cited Case Law	19

TABLE OF CITATIONS.

Attwood, In re, 45 CCPA 824, 1958 C. D. 204, 730 O. G. 790, 253 F. (2d) 234, 117 USPQ 184	17
Cohn v. Corset Co., 93 U. S. 366, 23 L. Ed. 907 (1876) ..	16, 17
Crosley et al., In re, 34 CCPA 882, 1947 C. D. 216, 600 O. G. 172, 159 F. (2d) 735, USPQ 499	17
Decker, In re, 1911, C. D. 274, 162 O. G. 999, 36 App. D. C. 104	17

II.

	PAGE
Dewey & Almy v. Mimex, 124 F. (2d) 986, C. C. A. 2 (1942)	16
Eastman Kodak Co. v. Coe, 78 U. S. App. D. C. 403, 135 F. (2d) 836	21
Marden and Rentschler, In re, 18 C. C. P. A. (Patents) 1119, 48 F. 2d 428, 8 U. S. Pat. Q. 515	17
Merck & Co., Inc. v. Marzall, 1952 C. D. 35, 661 O. G. 576, 197 F. (2d) 206, 93 USPQ 355	18, 19
Schaeffer, in re, 2 App. D. C. 1, 8 (1893)	16
Von Bramer et al., In re, 29 C. C. P. A. (Patents) 1018, 1024, 127 F. (2d) 149, 53 USPQ 345	17, 18
Wisconsin Alumni R. Foundation v. George A. Breon & Co., 85 F. (2d) 166, C. C. A. 8 (1936)	15

STATUTE.

35 United States Code:

Section 102(b)	2, 3, 4, 5, 7, 10
Section 112	2, 3, 10, 14
Section 162	3, 6, 9, 14
Section 161	4, 6

MISCELLANEOUS.

Manual of Patent Examining Procedure:

Chapter 608.01 (p)	20
Chapter 706.03 (p)	21
Walker on Patents, Deller's Edition, page 269	15

United States Court of Customs
and Patent Appeals

Patent Appeal Docket Nos. 6727 and 6728

IN THE MATTER OF THE APPLICATIONS OF
EDWARD BURTON LEGRICE

APPEAL FROM BOARD OF APPEALS OF
THE UNITED STATES PATENT OFFICE

Serial Nos. 709,127 and 709,128

BRIEF OF APPELLANT

I. Statement of Case.

This is an appeal from the decisions of the Board affirming the Primary Examiner's rejection of the conventional plant patent claim in each of the above two plant patent applications. The rejections are based on printed publications having effective dates more than one year prior to the filing dates of the applications.

The two Appeals herein are identical in substance and have been combined. They are referred to hereinafter as though a single application were involved.

The application oath specifically identifies the printed publication relied on for rejection.

The publication describes the plant adequately to establish its identity with the plant of the application.

The Examiner's final rejection was appealed to the Board which affirmed the Examiner and denied a Request for Reconsideration. Thereupon, this appeal was taken to this Court.

The above facts are the only ones of record that need be considered in deciding the issues. They are included in the Stipulation (Record, pgs. 6-9).

II. The Errors.

The errors relied on are as follows:

The Board erred:

1. In affirming the Examiner.
2. In misinterpreting 35 United States Code, Section 102(b) as applied to plant patents.
3. In rejecting the application on the interpretation of the above statute in the case of plant patents differently from the long established interpretation of the wording thereof in the case of mechanical and article patents.
4. In applying the statute in what the Examiner held to be its exact and unequivocal meaning.
5. In holding, in rejecting the request for reconsideration of its decision, that the decisions demonstrate there is no inconsistency between what properly constitutes a publication under Section 102(b) in mechanical cases and what constitutes a publication under Section 102(b) in the case of the present plant application.
6. In misinterpreting 35 United States Code, Sections 102(b) and 112, and holding that the former should be

taken in its exact and unequivocal meaning, despite the exception made to Section 112 by Section 162, which latter expresses a legislative intent in case of plant patents, to liberalize the meaning of the wording in Sections 102(b) and 112 as compared to that in the case of mechanical patents.

7. In holding, impliedly, that the granting of a plant patent on a non-enabling disclosure in an application is indicative that a ~~non~~³⁵-enabling disclosure should be adequate for anticipation, whereas the former is based on a specific exception made in the statute and the latter is not.

8. In holding that the applicant's interpretation of the law as established by court decisions is in error and is a misinterpretation of the decisions.

9. In holding that the decisions relied on by the Board are contrary to the appellant's interpretation of the law and that a complete description of an article in a reference is all that is required to defeat claims to the article, even though there was no known way of making the article in the reference.

10. In partially misconstruing the appellant's contention as to the nature of a publication required for anticipation under the patent laws.

III. The Broad Issue.

The broad issue is whether the words "described in a printed publication", in 35 U. S. Code, Section 102(b), (Record, Page 8), are to be taken, as contended by the Examiner, in their "exact and unequivocal meaning", or interpreted, as contended by the appellant, in accordance with their long established meaning.

It is believed that the Board and appellant are in agreement that:

1. A description of a plant in a printed publication cannot enable one to practice the invention by producing the plant.

2. 35 U. S. Code, Sect. 102(b) applies to plant patents.

3. The disclosure contained within the four corners of a publication need not be enabling per se, if, in view of the existing knowledge of those skilled in the analogous art, it would enable others to make the particular article therein described.

4. Plant patents are ~~most~~^{more} nearly analogous to article and composition patents than to apparatus and method patents.

IV. Brief Statement of Appellant's Case.

The Appellant's reasoning in support of his position is as follows:

(a) The words "described in a printed publication" appear only once in 35 U. S. Code, Sect. 102(b), and this one use refers to "patents" without limitation as to the subject matter thereof.

(b) 35 U. S. Code, Sect. 161 states that Sect. 102(b) is applicable to plants.

(c) These words "described in a printed publication" cannot be applied in their "exact and unequivocal meaning" because they do not have an "exact and unequivocal meaning". Hence they must be interpreted.

(d) These words have been used in the mechanical patent law since long before plant patents were authorized, and admittedly required, and received, court interpretation as to what nature of description is proper for rejection.

(e) These interpretations have ~~been~~ established that the words mean a description which is complete enough, in view of the state of the analogous art, to *enable* one skilled in the art to practice the invention,—that is, an enabling disclosure.

(f) A description of a plant in a publication cannot *enable* one to produce the plant.

(g) Since a prior description cannot be “enabling”, it is not a description within the long established, and now unquestioned, meaning of the word “described” as used in Sect. 102(b).

(h) To permit rejection of a plant application on a prior printed description of the plant, the single use of the word “described” appearing only once in Sect. 102(b) must be interpreted to have two diametrically opposite meanings,—an *enabling* description as applied to article and composition patents, and a *non-enabling* description as applied to plant patents.

(i) There is no indication in the statute that Congress intended two such antithetical meanings.

(j) Since an interpretation to permit rejection on a non-enabling description would overthrow the long established patent law as to adequacy of descriptions in prior printed publications, it must be assumed that if Congress had intended so drastic an action, it would have clearly and specifically said so.

(k) The intent of Congress in passing the patent statutes was to make the use and benefit of patented inventions available to posterity.

(l) This intent can be carried out in the case of plants only by interpreting the words “described in a printed publication” the same when applied to plant patents as

when applied to mechanical cases, including articles and compositions.

Let us now review the situation and argument.

V. Basic Aspects of the Patent Statutes.

The Plant Patent Act was engrafted on the mechanical patent law, by Sect. 161, with all the rules, regulations and provisions of the latter made applicable to the former, except that, by Sect. 162, a plant patent could not be declared invalid if a description were as complete as was reasonably possible. Sect. 162 indicates that Congress recognized that there could be no enabling disclosures in the case of plants.

This hasty engraftment by Congress cannot be criticized. A plant patent act had long been sought. An opportunity affording likelihood of passage could not be lightly tossed aside by those who had worked long and arduously toward its passage. Sensibly, they passed the act hastily, when the time was opportune, realizing that future amendment to improve faulty draftsmanship would be much easier of accomplishment than seeking perfection at the inception.

As a result, the law of plant patents is so inextricably bound up with the earlier mechanical patent law that the former cannot be understood without consideration of the latter.

Patent law is devoted to practicalities, not theoretical concepts. Its purpose is to assure availability of physical res which can be turned to useful ends. The device for accomplishing this objective is the grant of a patent to an inventor in return for a disclosure which, in view of the art, will enable others to practice the invention to the end that the knowledge be recorded and thus preserved for posterity.

Permitting one to profit by his invention indefinitely by delaying filing until he learned another independently had made the same invention would lead inventors to chance secrecy for long periods and tend toward the very mischief sought to be prevented. Therefore, the inventor was encouraged to file promptly and limitations were placed on the time within which a valid application could be made after a prior public use or a description in a printed publication. It mattered not whether the printed description was made by the inventor or others. The inventor still was required to file before the deadline. But the description had to be an *enabling* one, else it would be no contribution to the public store of *useful* knowledge. The limitation as to a prior description is incorporated into Sect. 102(b).

VI. The Problems Posed by the Inherent Differences in Plants and Man Made Articles.

If a variety becomes extinct, a duplicate cannot be fashioned. The developer may disclose the ancestry and steps taken to obtain the variety and fully disclose its characteristics. Others can make an infinite number of crossings of the ancestors, but not one of them can recreate the variety. It has never been done. A plant by nature is different from man made res.

Articles can be created by man himself. Prior written descriptions can be such as to enable others to reproduce them. The public should be protected in the right to make use of information long before published, without danger of molestation under patents resulting from applications filed long after the publication. Otherwise, the utmost confusion would arise.

The description of a plant in a plant patent or in a printed publication at best can only recite, as historical

facts, that at one time a certain plant existed, was discovered in a certain manner, and was asexually reproduced. This information may be interesting history, but cannot enable others to reproduce the plant. Therefore, no matter the age of the publication, it cannot take from the public that which had long before been invented and, by publication, placed in public domain. Prior public use and sale of a plant are the avenues by which a plant enters the public domain.

Refusal of a plant patent on the grounds of the prior publication induces the developer to forego marketing the plant. He reasons that because a patent is barred by the publication, others can obtain and asexually reproduce the plant without obligation to him. It is to his personal benefit, therefore, to substitute in the market another plant on which he can obtain protection, even though the substitute be inferior.

Thus, in article patents, the basis is valid because the publication itself enables the public to produce the res at any time and the public should not be deprived of rights to that which has long been in the public domain.

A plant patent if granted on an application filed years later than a published printed description does not monopolize anything which formerly was in the public domain.

In the case of plant patents, therefore, the basis is illogical and invalid because it inures to the disadvantage of the public, by inducing the developer to forever deprive the public of the choice variety described. It contravenes entirely the intent of the patent laws.

In the case of an article, deliberate introduction of an inferior article could well inform the public sufficiently so that others could produce a specimen as desirable as the choice specimen the applicant would have preferred to have introduced could he have obtained a patent thereon.

Ho
its d
Why
only
full
good
enab
A
able
poss
serv
dist
in a
res
velo
publ
add

It
an
dile
visi
arts
out
be
scri
of
lowi
disc
to b

A
do
ach

How then does a plant patent perform its functions, since its disclosure cannot enable others to produce the plant? Why was an exception made in Sect. 162 of 35 U. S. Code only in the case of plants to the effect that other than a full disclosure is acceptable in an application if it is as good as can reasonably be supplied, thus allowing a non-enabling disclosure in the case of a plant application.

A plant patent performs its function by making it profitable to the developer to make as wide a distribution as possible of the res, the plant itself. If the variety is deserving, hundreds of specimens are likely to be widely distributed, thereby reducing the danger of their perishing in a common disaster. The likelihood of extinction of the res before an improved variety or worthy successor is developed is thus rendered remote. Publicity informs the public where specimens exist. This is how a plant patent adds to the store of *useful* knowledge.

VII. The Solution of the Problem.

It is this difference in the inherent nature of a plant and an article that presents what at first appears to be a dilemma resulting from the engraftment of the plant provisions on those originally designed for the mechanical arts. This apparent dilemma can be readily resolved without doing any violence whatever to the existing act. *It can be resolved simply by interpreting the meaning of "described in a prior publication" exactly the same in the case of plant patents as in the case of article patents,—by following the long accepted meaning that the prior printed disclosure must be enabling, in view of the art, in order to bar a patent.*

Adherence to the established meaning not only does not do violence to the case law and the patent statutes, it achieves the end meant to be accomplished by the latter.

Following the established interpretation, that an *enabling* disclosure is meant, renders the patent law, originally directed to mechanical patents, effective in the case of plant patents in the same manner and scope as it is effective for man produced res. It tends to assure that the public in the future can enjoy the res itself,—in the case of plants because the plant will be preserved; in the case of an article because it can always be reproduced.

It is true that on this basis no prior publication describing a plant, no matter how complete it may be, can defeat the grant of a plant patent.

A seeming paradox arises in that defeating an article patent by a prior publication achieves the same result as that obtained by refusing to defeat plant patent by a prior publication, even while interpreting the word "described" identically in each instance. The result in each instance is to assure that the public can enjoy the use of the res with a minimum danger of its being forever lost.

The seeming paradox results from the nature of the res, but is without substance. It vanishes if both the established interpretation of the word "described" and the intent of the patent laws are adhered to without deviation.

VIII. The Error in Misinterpreting 35 U. S. Code, Sect. 102-B and 112 and Holding that the Words "Described in the Printed Publication" Should be Taken in Their "Exact and Unequivocal Meaning" When Applying the Statute to Plant Patents.

The broad issue herein presented has not arisen heretofore. One must resort to the case law of mechanical patents as it existed prior to the plant sections.

This affirmed ruling of the Examiner raised three points, as follows:

(a) Must the words "described in a printed publication" be taken in their exact and unequivocal meaning; or

(b) Is it necessary to carrying out the intent of the Congress that they be interpreted; or

(c) In the event either (a) or (b), what is meant by "description"?

Statutes, due to inexactness of language, must be interpreted by Courts.

These words have never been taken in their "exact and unequivocal meaning", if for no other reason than they do not now, and have never had, an exact and unequivocal vocal meaning.

They require interpretation and explanation to impart definiteness and clarity to the law to the end of carrying out the intent of Congress as it is evidenced by the statute itself, the history of the legislation, and prior case law.

That the words in question are not exact per se is made evident by the following examples:

Suppose that the description recites the applicant had: (1) discovered a new rose; (2) discovered a new rose having an unusual color; (3) discovered a new rose having specified characteristics and illustrated in an accompanying drawing; (4) developed a new yellow rose by crossing X and Y; (5) discovered a new rose which is now being tested in an identified test field and itself identified by a recited test number.

With these enumerated possibilities, exactly where, if at all, does the description become a printed "description" disclosing the rose, disregarding for the time being that no description of a plant can be enabling. Certainly, the mere statement that one has discovered a new rose having a beautiful yellow color would not be such a description.

Would the mention of its hardness in addition make it one? What if the parents are mentioned?

Innumerable gradations of description can be devised for plants and articles. Though all would be descriptions, some would not be adequate descriptions, others would be. Many would be in the vague twilight zone between. Courts simply have to interpret statutes to set the metes and bounds of the statutory law.

It is believed evident that the words cannot be taken in their "exact and unequivocal meaning", but must be interpreted.

In patent law, the Courts have established the test of a description to be whether or not, when supplemented by the known analogous art, it is so full and complete as to enable one skilled in the art to practice the invention.

These words have consistently been held to mean an "enabling" description. There is no indication that Congress meant to overthrow all patent office and court interpretations of the meaning of these words in the case of plants. Particularly, there is no indication that Congress intended they should be used in their "exact and unequivocal meaning" when applied to plants and "interpreted" otherwise when applied to articles. And there is no indication that in the single instance in which they are used, they should have two antithetical meanings,—“enabling” for articles, “non-enabling” for plants.

If “description” does not have to be an enabling one, then the metes and bounds of “description” heretofore established by the Courts are completely lost and no criteria whatever remain for determining where to draw the line between adequate and inadequate disclosures.

It may be that prior descriptions of plants could have utility in rejecting a plant application because, even though

the
be
aft
pla

I
fro
of
in
ma
fiel
He
gro
wh
th
re

ar
mi
me
de
st
is
te

za
du
to
de
ci
to
fo

the claim were for the specific plant, the disclosure might be useful in showing the characteristics of the prior plant after proof that the plant did, in fact, exist and was the plant described in the publication.

IX. The Law Should Encourage Prompt Printed Disclosures of New Varieties of Plants.

Because of the inherent nature of a plant as distinguished from an inanimate res, a plant requires a different manner of marketing and development. A plant cannot be raised in any practical quantity in secrecy. A responsible nurseryman does not grow his original stock of plants in a secluded field and then introduce them, without more, on the market. He first distributes them to test fields where they can be grown under widely varying conditions in order to learn whether they are likely to grow and produce satisfactorily throughout the market area. Often several seasons are required for such tests.

Again, test fields awards and awards in flower shows are not primarily for determining economic benefits that might be derived from offering a plant sale. They are means of submitting the plant to groups of experts to determine whether a particular plant is, in fact, as outstanding as believed by the developer; in short, whether it is distinct, not necessarily in ancestry, but in those characteristics which make it outstanding over other plants.

The publication of descriptions of such plants in organizational publications does not inform readers how to produce the plant, but is desirable as it is an open invitation to others to call attention to other plants pertinent for determining whether, in fact, the published plant is sufficiently distinctive to justify multiplication. Sometimes too, it informs other developers what stocks might be used for crossing in seeking certain characteristics in new varie-

ties they are attempting to develop. For these reasons, the law should be interpreted to encourage prior publications and to encourage filing only on those plants which are recognized as outstanding by those in the art.

X. Congress Did Not Intend Any Change in the Established Meaning of the Words.

Congress did not intend to decree wholesale abandonment of the long established law with possible invalidation of thousands of patents by all manner of publications which are not enabling. Had Congress intended so revolutionary a step, it would not have done so by implication. It would have set forth its intentions in a clear and forthright manner. Congress must have intended to adhere to the long established law that an enabling description is required for rejection. That it had such intention is evidenced by the fact that when it wanted to specify a different type of disclosure in the case of plant patent applications, it did not rely on implication and possible interpretation of the words in question to give them two antithetical meanings, but, in Sect. 162, made a specific exception to Sect. 112.

The choice is simple. The first is that Congress considered the overthrow of all the long established meanings of long familiar words used in the statutes so unimportant that it did not bother to specifically overthrow them, but did so by implication. Under this choice, the present application must be refused.

The second choice is that Congress meant the words to have their long established meaning. Under this choice, the present application must be allowed.

The third choice is that Congress intended the same words in the same sentence to have two diametrically opposite meanings,—a totally illogical assumption.

If
some
mind
on th
hardl
by to

Th
tion
itself
a tea
ing i
cont
tion
be n
desc
for f
Th
tion
begin
as th
scrip

If assumptions are to be made, it is more logical to assume that Congress did not have all the implications in mind when it hurriedly engrafted the plant patent sections on the mechanical patent statutes. Such an oversight could hardly be the basis for holding that Congress meant thereby to repeal the established case law.

XI. The Case Law.

The law is established that an article patent, or rejection thereof, can be based on a disclosure of the article itself (a) if the disclosure contains, within its four corners, a teaching of how the article can be made if no way of making it is known in the art, or (b) if the disclosure does not contain a teaching of how it can be made if, from observation of the article itself, it is apparent how the article can be made by means known in the prior art. If the prior description provides nothing more than a starting point for further experiments, it is inadequate.

The nature of the prior description adequate for rejection is set forth in Walker on Patents, Deller's Edition, beginning page 269, and the decisions cited therein, such as the following which show clearly that an *enabling* description is meant.

"But the knowledge derived from the publication relied on must be sufficient to enable those skilled in the art to understand the nature and operation of the invention and *to carry it into practical use.*" (Wisconsin Alumni R. Foundation v. George A. Breon & Co., 85 F. (2d) 166, C. C. A. 8 (1936).)

"Novelty is not negated by any prior patent or printed publication, unless the information contained therein is full enough and precise enough to enable any person skilled in the art to which it relates, to perform the process or make the thing covered by the patent sought to be anticipated." (Wisconsin Alumni R. Foundation v. George A. Breon & Co., 85 F. (2d) 166, C. C. A. 8 (1936).)

"And a claim for an article of manufacture may be anticipated by a prior patent or printed publication, which describes the article, without describing any process of making it, *provided a knowledge of the article would teach a skillful mechanic some process of making it.*" (Cohn v. Corset Co., 93 U. S. 366, 23 L. Ed. 907 (1876; in re Schaeffer, 2 App. D. C. 1, 8 (1893).)

"If an alleged anticipating patent offers no more than a starting point for further experiments, if its teaching will sometimes succeed and sometimes fail, if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation." (Dewey & Almy v. Mimex, 124 F. (2d) 986, C. C. A. 2 (1942).)

XII. Discussion of Cases Cited by the Board.

The Board held (record, page 25) that disclosure of an operative method of making an article is not essential to an anticipation. It stated it believed the Appellant had misinterpreted the case law. It said Cohn v. U. S. Corset Co., 93 U. S. 366, 23 L. Ed. 907 (1876), relied upon by the Appellant, did not require in the reference a teaching of how to make the article.

The Appellant believes that he did not misinterpret the case law. Admittedly, the Cohn case did not require an enabling disclosure *in the reference*, since the article in that case was one which, the Court noted, could be made readily by means well known in the art.

It is well established that the reference itself need not disclose within its four corners a method of making a claimed article if it is obvious from the examination of the article how it can be made *by means known in the art*. The Board apparently interpreted the case in the same manner as the applicant, but it misapplied the case to an article, a plant, as to which there was not only no disclosure *in the*

reference as to how to make the plant, there was no way or means known in the art how to make the plant, and there is none today.

The Court said (record, page 26) that the Cohn case, *supra*, stands for authority for the proposition that inoperativeness of the *reference procedure* is immaterial and that a complete description of the article in the reference is all that was necessary, and is so interpreted by the Court of Appeals of the District of Columbia, in *In re Decker*, 1911, C. D. 274, 162 O. G. 999, 36 App. D. C. 104.

Here again, the Appellant finds no fault with the Cohn case or that interpretation. The Board said that the Court of Appeals ruling was followed in *In re Marden and Rentschler*, 18 C. C. P. A. (Patents) 1119, 48 F. 2d 428, 8 U. S. Pat. Q. 515, and that the principle remains controlling law as evidenced by recent decisions including *In re Attwood*, 45 CCPA 824, 1958 C. D. 204, 730 O. G. 790, 253 F. (2d) 234, 117 USPQ 184.

It said the Court in the Attwood case held that if an article is disclosed in a prior patent, an article claim can be rejected thereon even though *the process by which the patentee claimed the product could be produced was inoperative*. Again the Appellant finds no fault with the decision. The Board cited *In re Crosley et al.*, 34 CCPA 882, 1947 C.D. 216, 600 O.G. 172, 159 F. (2d) 735, USPQ 499, to the effect that a publication clearly disclosing an article can anticipate an article claim and the operativeness of the processes by which the publication said the article could be produced is immaterial. The Court was referring to the particular processes *disclosed in the publication itself*.

It cited the Marden and Rentschler case, *supra*, and *In re Von Bramer et al.*, 29 C.C.P.A. (Patents) 1018, 1024, 127 F. (2d) 149, 53 USPQ 345, to the effect that the appel-

lant could stand in no better position where the *patentee* discloses no process, or where the appellant cannot discern *from the patent disclosure* how to construct the article.

The Von Bramer case merely held that an operative process need not be shown in the reference itself, the Court holding that the name of the chemical defined therein by molecular structure was one having generally predictable properties and generally capable of synthesis by the *recognized classical organic reactions*.

The Appellant finds no fault with these prior decisions, nor with the Board's statement of them. He does find fault with the manner in which the Board takes this series of holdings which merely state that the means or method of making the disclosed article *need not appear in the four corners of the disclosure itself*, and applying them to a case in which means for producing the article (plant) are *not disclosed* either in the four corners of the prior publication *or anywhere else in the art*, and in which admittedly there is no known manner of producing the article (plant). (See record, pages 20 and 24.)

In each cited case, except the Merck case, *infra*, the Court held only that a disclosure of means of making the article need not appear in the four corners of the disclosure.

Citations are unnecessary to the effect that a prior publication can always be supplemented by the existing knowledge in analogous art. It is believed that in each case, the Court was speaking with knowledge that the article could be made by some means known in the art, even though no operative means, or some inoperative means, was described in the disclosure.

The case law simply does not sustain the Board's position that a prior disclosure of an article can be an antici-

patio
there
later

M
197
pou
itsel
man

T
The
cour
od,
by w
wou
ther
to n
Thi
law

XII

T
tha
ade
in
mal
pos

A
gus
a w
tha
gre
sm

pation of a subsequent claim to the article even though there is no way known to make the article at the time of the later application, as in the present case.

Merck & Co., Inc. v. Marzall, 1952 C.D. 35, 661 O.G. 576, 197 F. (2d) 206, 93 USPQ 355, was to the effect that a compound can be rejected on a prior disclosure of the compound itself even though no practical means for its isolation or manufacture was known.

The key word in this decision is the word "practical". The Appellant fully agrees with the decision providing, of course, that there existed, at the time of filing, some method, even though impractical for ordinary commercial use, by which the composition could be made. Such a disclosure would enable one to produce the article and any invention thereafter would have to reside in the process, for example, to make the process practical for commercial production. This seems to the Appellant to be the long accepted case law. The word "practical" is not to be ignored.

XIII. The Dangers Inherent in the Board's Interpretation of the Cited Case Law.

To hold that the cited cases stand for the proposition that description of an article in a printed publication is adequate to anticipate even though no way is disclosed in the publication and no way exists in the prior art, to make the article, is to open a Pandora's box. Consider the possible results from such a holding.

A science fiction magazine publishes a picture of a rocket gushing orange colored flames and carrying passengers on a weekend sight seeing tour to Mars. The article mentions that comfort of the passengers is assured by an artificial gravity field and external anti-gravity devices supply smooth and friction free propulsion force, etc. Fifty years

and hundreds of skilled scientists later, someone discovers how such a rocket can be produced. He produces and demonstrates it and then files an application claiming it. Under the Board's ruling and interpretation of the case law, he could be rejected on the fanciful disclosure of the magazine.

Again, someone publishes an article showing what appears to be an ordinary plate of glass, describing it as flexible and unbreakable because of a peculiar molecular arrangement of its constituents. Later someone actually invents such glass and teaches how the trick is to be turned. Is his application to be rejected on the inoperative disclosure?

Let us turn to perpetual motion machines on which patents are rejected by the Patent Office on the basis that there is no known way of making such a machine and they are, therefore, inoperative. Will the inventor who one day produces and demonstrates the operativeness of such a machine be rejected on the prior publication?

That there must be some known way of producing the article or composition, if not disclosed in an application, then in the prior art, is well recognized by the Patent Office, as shown in the following citations:

Manual of Patent Examining Procedure, Chapter 608.01 (p).

. . . A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention.

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques where necessary, as to enable those persons skilled in the art to make and utilize the invention.

... Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula . . .

Manual of Patent Examining Procedure, Chapter 706.03 (p).

A rejection on the ground of lack of utility includes the more specific grounds of inoperativeness, involving perpetual motion, frivolous, fraudulent, against public policy.

Likewise, an enabling disclosure is required in prior art relied on for rejection.

The Court should not overlook the fact that publications are now available of "things to be invented", with descriptions of what they are to do and often under what conditions they are to operate, with overall size, shape, and the like specifications,—in fact, everything except "how to make it". Is such a publication to be used for rejecting any article which happens to have been suggested therein a year before a filing? Such would be necessary under the holding of the Board.

In *Eastman Kodak Co. v. Coe*, 78 U. S. App. D. C. 403, 135 F. (2d) 836, the claims were granted to the applicant on the basis that the reference did not show how the product was produced, but merely stated its existence, giving the formula. The Court said that a mere statement that such a compound may exist is inadequate basis for rejection.

If the Board holds that a prior disclosure is adequate though no means are shown or known in the art for making the article disclosed, the Board is simply overthrowing all of the long established case law. Any attempt so to do should be aborted at its inception. The chaotic condition in the Patent law which would result from such a holding

could repeal for all practical purposes the patent system at the very time it is most needed to protect the individual inventor. It could be repealed by those interested in so doing by their publishing monthly descriptions of all manner of fanciful articles, compositions, and plants that their artists and employees could possibly conceive of, attributing to ~~these~~ their imaginative articles those characteristics which they would like to have them possess.

It is believed, therefore, that:

The interpretation requested by the Appellant is sound and would carry out the intent of Congress and benefit the public.

"Described in a printed publication", as used in the act, must be interpreted, as the words cannot be applied in an "exact and unequivocal meaning",—they don't have one.

The interpretation should be the same in the case of plant patents as in the case of mechanical patents or article patents. It should be the interpretation long established by case law; namely, that the words mean that an *enabling* disclosure is required.

Such an interpretation will encourage those who have new plants to proceed to reproduce the plants asexually and distribute them so that the likelihood of their being irrevocably lost is greatly reduced.

An affirmance would prevent the rejection of a plant application on any prior printed disclosure whatever, and thereby would accomplish in the case of plant patents that which is accomplished so well in the case of articles under the mechanical patent laws, thus assuring the availability of useful res to posterity.

The decision of the Court in this cause can have a profound influence on the development of the plant patent law

for years to come, either directly by establishing a judicial precedent or indirectly by influencing remedial legislation. It can determine which plants shall live and which shall be forever lost to mankind.

Reversal of the decision of the Board of Appeals and allowance of the claims in issue ^{are} ~~is~~ respectfully requested.

Respectfully submitted,

JOHN H. LEONARD,
Attorney for Appellant,
1562 Hanna Building,
Cleveland 15, Ohio.

Of Counsel:

SPENCER B. MICHAEL,
Of Smith, Michael & Gardiner,
Woodward Building,
Washington 5, D. C.

THE STATE OF NEW YORK

IN SENATE

JANUARY 1, 1901

REPORT OF THE

COMMISSIONER OF THE LAND OFFICE

FOR THE YEAR 1900

ALBANY:

THE STATE PRINTING OFFICE

1901



**United States Court of Customs
and Patent Appeals**

Patent Appeals Nos. 6727 and 6728

IN THE MATTER OF THE APPLICATIONS OF
EDWARD BURTON LEGRICE

FOR: ROSA FLORIBUNDA PLANT

BRIEF FOR THE COMMISSIONER OF PATENTS

INTRODUCTION

This is an appeal from the decisions of the Board of Appeals of the Patent Office (R-22 and 29) affirming the examiner's rejection of the conventional plant patent claim in the applications of appellant, Serial No. 709,127 and 709,128, filed January 15, 1958, each entitled "Rosa Floribunda Plant".

The rejection was grounded on the fact that descriptions of the plant have appeared in printed publications more than one year prior to the filing of the applications (R-22). By stipulation (R-6) the appeals were combined for proceedings before this Court, a single record was agreed upon, and the disclosures of the publications relied upon were conceded

to establish that the roses described and illustrated therein are the varieties described in the applications at bar (R-8). Appellant's brief (Br-2) re-affirms the statement in the stipulation that "the publication describes the plant adequately to establish its identity with the plant of the application". Accordingly the only issue involved in this appeal is the interpretation to be placed upon the language of Section 102 (b) of 35 U.S.C., as applied to plant patents. Appellant is in agreement (Br-3).

THE ARGUMENT

Section 102(b) of Title 35 USC

At the outset it should be noted that the examiner's letter of January 16, 1959 (R-10) indicates that the original application oath in each case refers to certain publications and catalogues published more than one year prior to January 15, 1958, the filing date of the involved applications, and that the stipulation (R-6) states that each application contained the conventional formal oath containing the averment that the applicant did not believe that the claimed variety of plant was described in any printed publication in any country more than one year prior to his application, but each stated additionally that "certain information" relative to the claimed variety was published in the National Rose Society Annual of England and in catalogues more than one year prior to the application date. However, this statement was qualified by the assertion that "he believes that such information cannot enable anyone to practice the invention by producing the present variety." On the

basis of applicant's oath statement the examiner held that these publications constitute a statutory bar under 35 USC 102(b) and finally rejected the applications (R-11). This rejection was sustained by the Board of Appeals (R-27).

In addition attention is also directed to the fact that in his answer (R-15) the examiner made reference to appellant's concession in his brief before the Board of Appeals that the catalogues showed a color picture of the rose which was clear enough to establish identity in appearance between the catalogue and the applicant's variety, and that they add to the information in the Rose Annual (the publication relied upon) a reproduction in color of a color photograph of the variety. Because of these facts (admitted in the Stipulation filed in this Court—R-8) the examiner suggests that the publication certainly negatives patentable novelty and precludes the grant of a patent under 35 USC 161. This suggestion was accepted by the Board as a rejection. (R-24). Since the Board's decision did not expressly overrule this ground of rejection, believed to have been made, it must be considered that that rejection was affirmed by the general affirmance of the examiner's rejection. *In re Widmer*, 26 CCPA 963, 102 F.2d 409.

The primary issue presented by these appeals is as stated by the Board (R-22) the competency of a prior printed publication to bar a plant patent; or as stated by appellant (Br-3) whether the words "described in a printed publication" in 35 USC 102(b) are to be taken, as phrased by the examiner (R-19) as they stand without interpretation, or, as contended

by appellant, interpreted in accordance with their long established meaning.

Section 161 of Title 35 USC (second paragraph) states that the provisions of the title relating to patents for inventions shall apply to plants, except as otherwise provided. The only exception provided appears in Section 162 in which Congress expressly included a statement that no plant patent shall be declared invalid for non-compliance with Section 112, relating to the need of a full and complete description of the claimed invention, if the description of the plant is as complete as is reasonably possible. Hence, all the provisions of Section 102 apply to plant patents as well as other patents. Appellant appears to agree (Br-4).

Ordinarily when the language of a statute is clear and unambiguous, the language is given its normal intended meaning. This is a rule of statutory construction so well known as to need no citation of authority. It is evident that the examiner was applying this well known rule when he stated that he "simply accepts the language of the statute as it stands and without interpretation" (R-19). The language of Section 102(b) is believed to be clear and to need no interpretation. That language states that for a thing to be patentable to any alleged inventor it must not have been described in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in this country. Appellant here concedes that the invention is described adequately in a prior publication to establish its identity with the plant of the application, and that

the date is early enough. (Br-3). However, appellant contends that something more is needed than a completely adequate prior description, namely, that the description must be an "enabling" one in order to bar a patent (Br-9, 22). And in support of his contention appellant urges that if the language of the section be interpreted exactly the same in the case of plant patents as in the case of article patents the conclusion would be that by following the accepted meaning that the prior printed disclosure must be an enabling one, (Br-9, 22) the rejection would be deemed improper.

This same contention was made before the Board of Appeals, and their response to it was to point out that appellant has misinterpreted the case law (R-25); that the adjudications hold that a complete description of the article in the reference is all that is required to defeat claims to such article (R-26), citing, among others, this Court's decisions in *In re Attwood* 45 CCPA 824, 253 F.2d 234, and *In re Crosly* 35 CCPA 882, 159 F.2d 735, where it is said that "this court is committed to the doctrine that . . . the disclosure of the composition is sufficient to anticipate a claim therefor"; and that application of that rule defeats appellant's claim for a patent.

Appellant's brief discusses the Board's interpretation of the law and the cases cited in support thereof, and states that the case law does not sustain the Board's position; and that the Board erred in holding that a prior disclosure of an article can be an anticipation of a subsequent claim to the article, even though there is no way known to make the article at

the time of the later application (Br-19). Since appellant's case is predicated upon the contention that the Congressional intent can be carried out in the case of plants only by interpreting the words "described in a printed publication" in Section 102(b) the same when applied to plant patents as when applied to mechanical cases, including articles and compositions (Br-5,6), it would appear that the decision in this case can best be determined by an analysis of the meaning attributed to that statutory language when applied to mechanical patents. Concededly if appellant's interpretation is incorrect, the decision of the Board warrants affirmance.

The landmark case on this aspect of the law is *Cohn v. U.S. Corset Co.*, 93 U. S. 366 cited in the Board's decision (R-25); and by appellant (Br. 16), who interprets the Court's ruling to be one in which an enabling disclosure was not required in the reference, because the article in that case was one which the Court noted could be made readily by means well known in the art. However, it should be emphasized that the Court said:

"It is quite immaterial, even if it be a fact, that the Johnson specification is insufficient to teach a manufacturer how to make the patented corset. It is enough if it sufficiently describes the corset it self The plaintiff claims a manufacture . . . ; and the important inquiry, *therefore, is whether the prior publication described the article.* To defeat a party suing for an infringement it is sufficient to plead and prove that the thing patented to him had been patented or described in some printed publication prior

to his supposed invention or discovery thereof.
... *what is required is a description of the thing patented, not of the steps necessarily antecedent to its production.*" (Italics added)

Clearly appellant's interpretation lacks support in this statement of the legal requirement.

In addition to the cases of this Court cited by the Board of Appeals (R-26,27), it should be noted that this Court has consistently followed the rule of Cohn v. Corset Co. as set forth in the following cases:

In re Fink, 20 CCPA 716, 62 F.2d 103;
In re Stoll, 34 CCPA 1058, 161 F.2d 241;
In re Michalek, 34 CCPA 1124, 162 F.2d 229;
In re Shackell, 39 CCPA 847, 194 F.2d 720;
In re Kebrich 40 CCPA 780, 201 F.2d 951;
In re Inman, 43 CCPA 709, 228 F.2d 229;
In re Baranaukas et al 43 CCPA 727, 228 F.2d 412.

And in addition to the cases of the Court of Appeals of the District of Columbia cited by the Board (R-26) there should be added the most recent case of that Court entitled *Shell Development Co. v. Watson*, 102 U.S. App. D. C. 297; 252 F.2d 861, in which the Court approved fully the conclusions of the District Court. In that case appellant likewise contended that the word "described" in the statute required something in addition to a mere description, that added something being called a "reduction to possession", a term obviously equivalent in meaning to the present appellant's emphasis upon the word "enabling" (Br-22). The decision of the District Court basing its ruling upon *Merck & Co. Inc. v. Marzall*, cited by

the Board (R-27), rejected this contention of the plaintiff in the following language:

"A clear description in a prior publication is all that is necessary under the law to bar a subsequent inventor from obtaining a patent on the identical thing. In other words, a prior publication, in order to defeat a patent, need only exhibit the thing claimed in such an intelligible manner as to enable persons skilled in the art to which the invention is related, to comprehend it. Defendant's refusal to grant the claim sought here based upon the Ring Index publication was proper for this court holds that the name and the structural formula contained in the Ring Index publication constitutes a sufficient description to anticipate. Plaintiff's claim 13 is clearly described in the publication within the meaning of the statutory language"

Accordingly, it is believed that the decisional law of the courts whose decisions govern proceedings in the Patent Office shows clearly and definitely that appellant's contentions are without merit. Not only have these courts rejected those contentions and those interpretations of the statutory language, but it is significant that other courts have likewise rejected similar contentions in infringement actions. The District Court of Maryland in *One-Piece Bifocal Lens Co. v. Bisight Co. et al*, 246 Fed. 450, interpreted the language "described in a printed publication" in old Section 4886 of the Revised Statutes (now in Section 102 of 35 USC) to mean that when the very thing claimed in a patent is clearly and accurately described in a prior publication, it will anticipate, even though

the publication describes no method of producing the article, and "even though at the time of the publication those skilled in the art would not either from its disclosure or their own knowledge, or from both combined, know how to produce it." That Court likewise rejected the contention that "reduction to possession" was necessary under the law. That case was affirmed by the Fourth Circuit Court of Appeals (259 Fed. 275), and certiorari was denied by the Supreme Court (249 US 606). In addition, the District Court of Delaware in *Gen. Elec. v. Deforest*, 17 F.2d 90, after an exhaustive analysis of many cases cited by the parties agreed with the rule of law of the *One-Piece Bifocal Lens Co.*, case; namely, that a clear prior description and nothing else is all that is necessary to constitute an anticipation. The concept of "enabling" was completely rejected.

Accordingly, it is submitted that the overwhelming weight of authority supports the proposition that a clear naked description in a prior publication is sufficient under the law to bar a subsequent inventor from obtaining a patent on the identical thing, and that appellant's contention that the statutory language means that an "enabling" disclosure is required is without merit.

Section 161 of 35 USC

Section 161 (First paragraph) heads as follows:

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than

a tuber-propogated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

This section requires that "a distinct and new variety" is necessary to suport a patent in this field. As pointed out in *Bourne v. Jones*, 114 F.S. 413, affirmed in 207 F.2d 173, in order to obtain a plant patent the patentee must invent or discover a new and distinct variety of plant and asexually reproduce the plant. A prior description of an existing plant adequate to identify the plant claimed would negative newness and cast extreme doubt upon whether the statutory prerequisite of "a new variety" is met. It is to be noted that appellant's reasons of appeal contain no reference to this ground of rejection based upon this portion of Section 161 of the statute, and appellant's brief contains no discussion thereof.

CONCLUSION

It is respectfully submitted that for the reasons advanced by the examiner and Board of Appeals, as supplemented herein, the rejection of appellant's plant application was proper. Affirmance of the rejection is solicited.

Respectfully submitted,

CLARENCE W. MOORE,
Solicitor, U. S. Patent Office.

JOSEPH SCHIMMEL,
of Counsel

February, 1961.

IN THE U.S. COURT OF CUSTOMS AND
PATENT APPEALS

In Re: Applications of
Edward Burton LeGrice

Serial Nos. 709,127 & 709,128

Filed: January 15, 1958

For: ROSA FLORIBUNDA PLANTS

PATENT APPEAL
NOS. 6727 & 6728

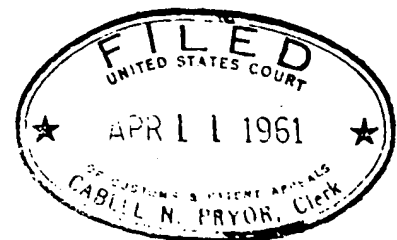
REPLY BRIEF

The brief on behalf of the Commissioner, page 10,
states:-

A prior description of an existing plant adequate
to identify it as the plant claimed would negative newness
and cast extreme doubt upon whether the statutory pre-
requisite of "a new variety" is met.

The answer is that "new variety" does not mean
"recent variety", but means the "first variety of its kind
to be produced".

A prior description of an invention by a prior
inventor may disprove "newness" as to the same invention
made by a later inventor, but an inventor's prior dis-
closure of his own invention cannot disprove novelty or
newness of the very invention disclosed. If an enabling
disclosure, it might constitute some statutory bar, but
this is unrelated to novelty.



Suppose the search is for a new variety having a life of ten years, as compared to two years for known varieties. One who produced a new variety could test it for the ten years to determine its adequacy, yet the variety would remain "new" under the statute.

The new cases in the Commissioner's brief do not sustain the position for which they were cited but, on the contrary, sustain the Appellant's position. Of the cited cases, the following hold only that the reference itself need not disclose how to make the article, while recognizing that the article had to be one capable of being made by methods known in the art, whether disclosed in the reference or in some other publication:

In re Fink; (relying on In re Marden, cited by Appellant);

In re Stoll; (the article is inherently produced by the methods of the cited reference, as admitted technically by Appellant therein);

In re Michalek;

In re Shackell; (relying on In re Von Bramer and In re Marden cited in Appellant's brief herein);

In re Kebrich; (relying on In re Crosley, In re Von Bramer, and In re Marden, cited in Appellant's brief herein);

In re Baranoukas; (the reference itself disclosed an inoperative method, but other methods were known);

Shell Development Co. vs. Watson; (the product could be made by known procedure);

One Piece Bifocal Lens Co. vs. Bisight Co.; (the product could be made by known procedure);

General Electric vs. DeForest; (required enabling disclosure in prior art).

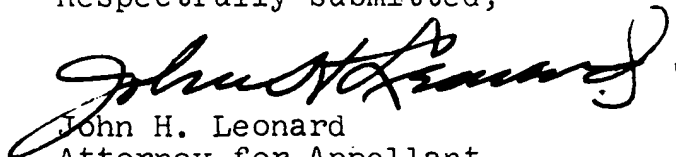
Two of the cases, based on different grounds, are as follows:-

In re Inman; (turned on a discovery of a new property in a raw material);

Bourne vs. Jones; (related to prior public use, and invalidity based on patent being issued to only one of two inventors).

The above prior cases rest on the basis that for description of an article itself to be anticipatory, it must be apparent from the article that it can be made by known methods, either methods in the disclosure or in the prior art generally.

Respectfully submitted,



John H. Leonard
Attorney for Appellant
1562 Hanna Building
Cleveland 15, Ohio

Of Counsel:

Spencer B. Michael
Of Smith, Michael & Gardiner
Woodward Building
Washington 5, D. C.

March 28, 1961

**United States Court of Customs
and Patent Appeals**

Patent Appeals Nos. 6727 and 6728

**RE: APPLICATION OF EDWARD BURTON LEGRICE
ROSA FLORIBUNDA PLANT**

PETITION FOR RECONSIDERATION AND REHEARING

**CLARENCE W. MOORE,
*Solicitor, U. S. Patent Office***

**J. SCHIMMEL
*Of Counsel***

INDEX

	PAGE
Petition For Reconsideration and Rehearing	1
Points 1 and 3	4
Point 2	17
Point 3	19
Conclusion	23
Authorities Cited:	
Cases:	
Bifocal Lens, page 27 of the decision.....	22
Cohn v. U. S. Corset Co. (1870) 93 U. S. 366.	6
Curtis on Patents, 3rd ed. Section 378..... (page 8 of the decision)	5
Decker (35 App. D. C. 104)	21
Downing v. Yeager case,	10
Eames v. Andrews case,	10
Gregg, In re 44 CCPA 904, 244 F.2d 316.....	19
General Electric case, (page 27 of decision..	22
Grissinger v. U. S., 77 Ct. of Claims 106; .. cert denied 290 U. S. 676.	20
Merck case, (page 32 of the decision).....	22
Michalek case, (page 30 of the decision).....	20
Schaeff r In re, 2 App. D. C. 1,	7
Robinson on patents, (pag 9 of th d cision).	5

	PAGE
Seymour v. Osborne, 11 Wall 516, 555 ... (page 8 of the decision.	9
Power Kennedy v. Concrete Mixing Corp.... 282 U. S. 172;	20
Walker on patents, (page 9 of the decision.	7
Western States Machine Co. v. Hepworth ... Co., 147 F.2d 345, cert. den. 325 U.S. 873	20
Wisconsin Alumni Research Foundation case..	10
Statutes:	
35 USC 103(b).....	1
35 USC 103(a).....	8
35 USC 161	18
35 USC 162	19

**United States Court of Customs
and Patent Appeals**

Patent Appeal Nos. 6727 and 6728

IN THE MATTER OF THE APPLICATIONS OF
EDWARD BURTON LEGRICE
ROSA FLORIBUNDA PLANT

PETITION FOR RECONSIDERATION AND REHEARING

The Commissioner of Patents respectfully petitions, under the provisions of Rule 7 of this Court, for reconsideration and rehearing of the decision dated May 4, 1962 in the above identified appeals, reversing the decision of the Board of Appeals, holding that since the inventions of the involved applications had been described in printed publications more than one year prior to the dates of filing of the applications, no patents could be granted, in view of the express prohibition of 35 USC 102(b).

The errors manifest in the decision of the Court, and the points which are believed to have been misapprehended or overlooked, and which require reconsideration and modification, or rehearing are:

(1)

1. On page 2 of the decision, the Court, referring to 35 USC 102(b), indicates that the courts had construed earlier statutory provisions with regard to what must be described in a printed publication in order for the publication to be a bar to the grant of a patent, and states that "The underlying concept on which the courts permitted such a bar is that the description of the invention in the printed publication was sufficient to give possession of the invention to the public."

On page 8 of the decision, the Court again states that "we find 35 USC 102(b) and its predecessor statutes have been interpreted as requiring that the description of the invention in the publication 'must be sufficient to put the public in possession of the invention'".

On page 14, the Court further states that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention".

And on page 20, the Court states that when used in Section 102(b) of the Patent Act of 1952, the clause "described in a printed publication" had acquired something other than an exact and unequivocal meaning attributed to it by the examiner and the Board of Appeals, as a result of the judicially imposed limitation that this clause requires that the description of the in-

vention in the printed publication must be an "enabling" description.

It is respectfully submitted that insofar as the Court's reversal of the Board's decision is based upon a purported limitation placed upon the statutory language by judicial interpretation, there is manifest error therein. If this Court's decision is intended to mean that, with respect to articles of manufacture or products, a prior publication must describe a process for producing the product or that such a process must be known at the date of the publication to one skilled in the art, before such a publication can be used to negative novelty, then it is submitted, for reasons more fully set forth hereinafter, that no other authoritative adjudication, so holds including those referred to in the Court's decision. No such limitation is imposed upon the statutory language, by any adjudication, prior to this; and hence, modification of the decision is necessary.

2. On page 21 of the decision, the Court expresses disagreement with the views of the examiner and the Board that, if only an "enabling" publication is effective as a bar to a subsequent patent, this necessarily means the plant publications must be totally ignored, on the ground that the facts of each case must be carefully considered to determine whether the description in the printed publication in question does in fact place the invention in the possession of the public. It is respectfully submitted that, this statement appears to ignore the facts pre-

viously developed in the Court's opinion that there are inherent differences between plants and manufactured articles and that it is impossible to duplicate plants from a disclosure.

3. On pages 26 through 32 of the decision, the Court discusses some of the adjudications relied upon by the Board and the Solicitor as authorities in support of the proposition that a clear naked description alone in a prior publication is a statutory novelty negating publication under 35 USC 102(b), and concludes that implicit in all the cited cases is the concept of a certain degree of knowledge possessed by one skilled in the art involved concerning the disclosure of the prior publication and the concept which was sought to be patented. It is respectfully submitted that, in arriving at this conclusion, the Court has overlooked certain facts, and departed from all precedents. For reasons more fully set forth hereinafter, it is believed that the Court should reconsider its decision, or grant the request for a rehearing.

POINTS 1 AND 3

Since the Court's decision in these appeals is said to be based upon the standards long recognized by leading text writers and the courts in the interpretation of the predecessor statute of 35 USC 102(b), it is believed that points 1 and 3 of this petition may properly be discussed together. Reference will first be made to the text writers mentioned in the order in

which the decision mentions them, and then the decisions will be discussed.

The first text writer referred to is Curtis on Patents, 3rd ed. Section 378 (page 8 of the decision). It is noted that this text bears a publication date of 1867, and that the section referred to, in posing the question "what, then, constitutes a description"?, states that "no judicial construction has yet been given to this term." Under these circumstances, it would appear that no further comment is necessary, since *Cohn v. Corset* was decided in 1870.

The second text writer referred to on the same page and on page 9 is Robinson on Patents. Section 325 appears to be quoted in toto, but the same cannot be said of Section 330, which the Court indicates is an elaboration of the fifth characteristic of a prior publication set forth in Section 325. The last two sentences of Section 330 which are believed to be important and significant to the issue of these appeals are:

"But this requirement relates only to the precise idea expressed in the invention. If, for example, this should be a manufacture, the method of producing it forms no part of the invention and therefore need not be described."

The term "this requirement" in the above quotation refers to the underscored portion of the quotation in the Court's decision (page 9). Accordingly, it is submitted that that portion of the fifth characteristic mentioned in Section 325, which states that the description must be so precise that any person can construct the invention without experiments, must be

read in the light of the above quoted portion from Section 330, and that, when so read it is clear that in the case where the invention is a manufacture, the prior publication need not have the characteristic mentioned. It is of interest to note that the text quoted above refers to a footnote which attaches a proviso to the text statement, and cites *Cohn v. U. S. Corset Co.* (1870) 93 U.S. 366. It is also noted that *Cohn v. U. S. Corset Co.* is referred to in Section 336, which equates patents with publications, and states that the rules as to sufficiency of description are the same, but significantly the note here states the principle that "where the invention is a product, the prior patent need not have described the method of producing it", and contains no proviso such as that in the note on Section 330. One further reference to this particular *Cohn v. U. S. Corset Co.*, case appears in *Robinson*, and that is in Section 499 in which the text is specific to inventions in a manufacture, and here, the text statement is that when the manufacture "can be understood" without it, the process by which it is produced need not be mentioned, and again the note to which reference is made like that in Section 336 does not contain the proviso included in the note to Section 330.

Accordingly, it is submitted that consideration of all these sections of the text of *Robinson* clearly points up the fact that where the invention is a manufacture, a clear prior description which is "understood" or "comprehended" by a person skilled in the art is all that is necessary to legally bar a later inventor from patenting that identical manufacture. Since the

claimed subject matter of the instant appeal falls into that category, it is evident that the totality of statements in Robinson supports the position of the Office tribunals.

The third text writer referred to on page 9 of the decision is Walker, and the paragraph quoted also contains a proviso referring to need for knowledge of the process of making. Walker cites *Cohn v. Corset Co.* and *In re Schaeffer* 2 App. D. C. 1, in support of the statement in his text. Though the language of this proviso differs somewhat from that of the proviso in the note to Section 330 of Robinson, referred to above, it may be assumed, for the purpose of this discussion, that they mean essentially the same thing. However, as pointed out above in the consideration of other Sections of the Robinson text, the decision in *Cohn v. Corset Co.* is stated to stand for the proposition that where the invention is a product, the prior publication need not describe the method of producing it. This is more clearly and definitely brought out in the Schaeffer case cited by Walker, where the decision states:

"It is well settled that where the claim is for a new manufacture, and not for the process of making it, it is not required that the prior publication shall be so specific as to teach how to make the article. The requirement is that the thing sought to be patented shall have been described and not the necessary steps antecedent its production."

In addition that court stated that the same doctrine appears in a recent work on patent law, citing and

quoting the same two sentences quoted in this petition from Section 330 of Robinson on Patents, but which were omitted from the quotation on page 8 of the decision. There being no real basis in the decision cited by Walker for the proviso included in the paragraph quoted, it is submitted that reliance upon this text writer, as authority for the proposition stated, is misplaced. Hence, the decision, rather than the text writer, should be looked to for the meaning of the prior statutory language.

Finally, the decision refers and quotes Sections 36 and 227 of Robinson on Patents. Section 36 is part of the chapter discussing "the nature of the monopoly secured to an inventor by letters-patent", showing that it is a justifiable monopoly. The significance of this section on the question of the legal sufficiency of a printed publication is not apparent. And since section 227 is directed specifically to the "known or used" portion of 35 USC 102(a), and defines what constitutes "knowledge" as a novelty negating factor, its significance on the issue of these appeals, likewise, is also not apparent.

Accordingly the detailed review of the texts referred to in the decision shows that the Court has overlooked material and important statements in those texts. Failure to consider all these statements apparently has led to a misapprehension of the standards and principles applied by the courts for more than a half-century in determining the meaning of statutory language similar to the language in 35 USC 102(b), i.e., described in a printed publication. Reconsideration of the decision or rehearing of these

appeals because of these facts alone would be warranted.

Consideration will now be given to the decisions referred to. The first court decision cited in the Court's decision in these appeals, as establishing the standard of legal sufficiency of a printed publication is *Seymour v. Osborne*, 11 Wall 516, 555 (page 8 of the decision). This case is cited in both *Walker*, (p. 270) and *Robinson* (Sections 329, 330), and the portion quoted by both writers is identical to that reproduced on page 14, of the decision in these appeals. Attention is directed to the statement by the Supreme Court that "the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention and to carry it into practical use." The Supreme Court does not say that the description of the publication must be an "enabling" description. All that it holds is that it must be sufficient to enable the art to "understand" the invention. It is submitted that "understanding" is not the same as "enabling". This Court has overlooked the fact that that term was used in *Seymour v. Osborne*, as well as the fact, also, that the terms do not mean the same thing. Since this Court characterizes the decision in *Seymour v. Osborne* as setting forth the controlling view (p. 13 of the decision) it is surprising that the critical term "understand" is not referred to. It is believed that the use of that term is significant, because in the same connection in *Cohn v. U. S. Corset Co.* 93 U. S. 366, which will be discussed more fully hereinafter, the Supreme Court used the term "comprehend". In neither case does the Court

use the term "enabling". Clearly, the terms "understand" and "comprehend" have a common connotation, and that is all that the Supreme Court deems necessary. See Webster's International Dictionary.

On page 14 of the decision the Court refers to the Wisconsin Alumini Research Foundation case, the Downing v. Yeager case, and the Eames v. Andrews case, apparently as of interest on this principle. The first case cites Seymour v. Osborne, and quotes the identical portion which is quoted above in the third sentence of the preceding paragraph, and which contains the word "understand". Furthermore, the facts of the case show that the foreign publication relied upon did not disclose or teach the thing the patent teaches and claims. Therefore, except for pointing up the fact that the Eighth Circuit Court of Appeals recognizes that the Supreme Court's standard was "understandability" the factual situation makes the decision inapposite to the issue of this case, where admittedly the publications relied upon describe and depict the identical thing appellant now seeks to patent.

The second case, Downing v. Yeager, involved a process, which the court found was fully and clearly described in the German publication relied upon. It applied the rule laid down in the following passage from Cohn v. U.S. Corset Co:

"It must be admitted that, unless the earlier printed and published description does exhibit the later patented invention in such a full and intelligible manner as to enable persons skilled in the art to which the invention is related to

comprehend it without assistance from the patent, or to make it, or repeat the process claimed it is insufficient to invalidate the patent." (emphasis added).

While in this case the Court did say that the printed publications describe the process covered by the patent so fully and clearly as to enable persons skilled in the art to which the invention relates to carry on the process, nevertheless it is significant that the Court quoted that portion of *Cohn v. Corset Co.* which uses the term "comprehend", in stating the applicable rule. Adding this statement of the rule to that set forth in *Seymour v. Osborne*, *supra.* would seem to emphasize that the Supreme Court was thinking only in terms of "understanding" or "comprehending" which terms are synonymous, but distinctly different from the term "enabling" used by this Court.

The third case, *Eames v. Andrews*, also involved a process. The decision cites the rule of *Seymour v. Osborne* and *Cohn v. U. S. Corset Co.*, quoting the same portion of that decision which was quoted in the *Downing v. Yeager* case, in the preceding paragraph, and then states that the application of this rule to the publications relied upon shows that none of them can properly be said to anticipate the invention. Though the factual situation would appear to make the case inapposite to these appeals, it is important and significant that in each of these cases, the applicable rule relied upon and cited is that which uses the terms "understand" and "comprehend". Thus, each and every Supreme Court case refers to these two terms; no case uses the words "possession" or "enabling."

On page 14 of the decision, the Court set forth the "doctrine" of this case and states that it is in accord with the Supreme Court's decision in Cohn v. Corset Co. 93 U. S. 366, apparently on the basis of a single sentence extracted from the concluding paragraph of that decision. Though this case is discussed in some detail in pages 23 to 26 of the decision, the crux of the decision is said to be (p. 25) the same single sentence, previously referred to (p. 15).

It is submitted that this Court in concentrating its attention on this sentence has overlooked and ignored other parts of the Supreme Court's decision which the court itself considered important and crucial to the case. It is not unusual for a court to make a plurality of holdings, each of which is of equal value. This Court has repeatedly admonished the parties to consider all the facts of any decided case. Application of that admonition in determining what the Court held in the Cohn case should be considered, not only because the decision herein appears to break with a long established line of prior adjudications of this Court, as well as other courts as to the holding of the Cohn case, but also because in holding that the crux of the decision is found in the single sentence referred to, this Court has ignored other facts of the case and other holdings clearly set forth in the decision. The holding is unreasonable and unrealistic, and should be reconsidered.

The portions of the decision in the Cohn case which it is desired to emphasize and which this Court's decision appears to have overlooked, and perhaps misapprehended, are the following:

1. In discussing the patent in suit it is stated that "the specification nowhere sets forth the manner in which the alleged improvements in the corsets are produced No process is described. None is patented. The claim is for a manufacture, not for a mode of producing it". (93 U.S. p. 372).

2. In analyzing the invention of the patent, the court variously stated that all that it covered is "that the woven and closed pockets in the corset vary in length", or in other words "it claims weaving them (the pockets) of various lengths when closed. That is all." (p. 373.) Parenthetical words are added for clarity.

3. Having thus analyzed the patentee's invention and claim, the Court examined in detail the Johnson publication relied upon as an anticipation, quoting at length the entire description (p. 373), and concluded that "it is impossible, therefore, to find anything in the plaintiff's patent which was not with equal definiteness and perspicuity described in the printed publication (Johnson's specification), made nineteen years before the patent was granted." (p. 376, 377).

4. Further, immediately following the portion of the decision quoted in the preceding paragraph, the Court stated "it is quite immaterial, even if it be a fact, that the Johnson specification is insufficient to teach a manufacturer how to make the patented corset. It is enough if it sufficiently describes the corset itself" (p. 377).

5. At this point in the decision, the Court

again repeats what it had previously stated concerning the patent and the publication, namely, "Neither it nor the plaintiff's specification exhibits the process of making. Neither of them set up a claim for a process. The plaintiff claims a manufacture, not a mode of making it, and the important inquiry, therefore, is whether the prior publication described the article." (p. 377).

6. Then the Court repeats that "To defeat a party suing for an infringement, it is sufficient to plead and prove that the thing patented to him had been patented or described in some printed publication prior to his supposed invention or discovery thereof. . . . What is required is a description of the thing patented, not of the steps necessarily antecedent to its production." (p. 377).

7. And finally in the closing sentences, the Court states that "it is enough for this case that the invention patented to the plaintiff was clearly described in 1854, in the printed publication of the Johnson (Geresme) provisional specification. The patent is therefore, invalid, and hence the decree of the Circuit Court dismissing the bill must be affirmed." (p. 377)

It is submitted that these portions clearly, and unequivocally hold that if the publication describes the claimed article, process considerations are immaterial. The Court repeatedly states that a prior publication will defeat a patent for an article of manufacture "if it sufficiently describes" the article. The repetition of that statement in three distinct

places, including the final one "*that it is enough for this case* that the invention patented to the plaintiff *was clearly described* in 1854 in the printed publication, emphasizes, as nothing else could, that this was the important principle established by the case. The single reference to the known state of the art, which this Court has seized upon and elevated to the crucial holding of the case, overlooks and ignores completely the other holdings the Court, which it unequivocally states is "*enough for this case.*" Surely, if "*it is enough*" for that case that "*the patented invention was clearly described in the printed publication*", and if what the law requires to defeat a patent is merely "*a description of the thing patented*", since the publication description "*is enough if it sufficiently describes*" the article the mere fact that the Court made reference to the evidence in that case as indicating knowledge in the art of how to make the article, cannot, in reason, completely negate or override the other holding expressly made and remade. This single reference to the prior art's knowledge of how to make the article described in the publication was undoubtedly thrown in to meet contentions that the printed publication was legally insufficient because it did not disclose any process for making the article.

This Court's decision, on page 26, states that the court's opinion in the Cohn case directly referred to the prior art and the knowledge possessed by those skilled in the art, and concludes that it was because of this knowledge and only because of it, that the court said "*the important inquiry, therefore, is whether the prior publication described the article.*" How-

ever, it must be pointed out that this Court has misconstrued and misapprehended these references to the prior art and their significance. The initial reference to the prior art appears in connection with the application presented by the patentee to the Patent Office in 1874 (p. 371). The second reference to the prior art, likewise, was in relation to the patentee's specification (p. 372), and the fact that no claim was made for what had been done before (p. 373). The third reference to the state of the art again indicates that these elements well known to the art, are not claimed as a feature of plaintiff's invention (p. 373). The fourth reference to what "was well known" before the publication, related to what the court called "the sole distinctive feature of the plaintiff's invention", namely a variation in the length of the pockets relative to each other (p. 374), and the Court, interpreted language in the publication to mean that the limitation was fully met (p. 376). These constitute the references to the prior art, other than that said by this Court to be the crux of the decision. Certainly, the admissions made by the patentee in the prosecution of his application as to what was known to the art are of no significance, since the court said the patentee did not claim these as a feature of his invention. The only other reference to the knowledge of the prior art relates to the limitation in the patented claim that the pockets were of varying length, and the decision clearly indicates that the fact that persons skilled in the art knew the necessity of such variation was considered in interpreting the description in the publication (p. 376). Hence, it is sub-

mitted that this Court erred in stating that it was "only because of this knowledge" that the court holding is properly interpreted.

In this connection it is of importance to note that the whole tenor of the dissenting opinion is that the publication failed altogether to describe the means or mode of operation by which the pockets of varying lengths are to be closed in the weaving process (p. 398, 379). This dissent clearly emphasizes the holding of the majority of the court that disclosure of the process was immaterial. (p. 377). Likewise, it emphasizes the other holding of the majority that a prior clear description in a printed publication is enough, where the claim is for an article of manufacture..

POINT 2.

Inasmuch as the Court's decision in these appeals holds that only an "enabling" publication is effective as a bar to a subsequent patent (p. 21 of the decision), and inasmuch as the Court recognizes that with respect to plants "one cannot deliberately produce a duplicate even though its ancestry and the techniques of cross-pollination be known" (p. 11 of the decision) it is evident that a plant patent or publication cannot today be an "enabling" publication. Nevertheless the Court states its disagreement with the view of the examiner and the Board, and indicates that the facts of each case must be carefully considered to determine whether the description in the printed publication in question does in fact place the invention in the possession of the public. The

Court agrees that as a practical matter the descriptions in plant publications cannot be relied upon under 35 USC 102(b) (page 33 of the decision), presumably because they are not "enabling" descriptions. From a theoretical basis the Court speculates that the future may provide enabling disclosures. In the meantime, however, since no plant can be produced from the description in either patent or publication, the ultimate effect of this insistence upon an "enabling" disclosure is to read into the statute an exception, which Congress itself did not see fit to place there. Undoubtedly, Congress was aware of the fact that no description could possibly enable a plant grower to reproduce or make the plant, when it passed the original plant act in 1930. That knowledge was available also when the Patent Act of 1952 was enacted. In the light of such knowledge, it is unrealistic and unreasonable to assume that Congress permitted broad language to be used in 35 USC 102(b), relating to printed publications, and broad language in 35 USC 161 making the provisions of Title 35, including Section 102(b), applicable to plant patents, unless the intention was to make plant publications available as references. To require an "enabling" description which can not exist, as this Court recognizes, is in effect, to re-write the statute. It is submitted that, with respect to plants, there are no facts which could possibly place a described plant in the possession of the public. The intimation that some day the facts may exist, hardly warrants or justifies the rewriting ~~to~~ the statute to exclude all such publications as novelty negating references.

The fact that Congress made only one exception in connection with plant patents (namely that of Section 162) appears to have been overlooked by the Court. Reason dictates that if Congress had wanted to say that only "enabling" descriptions (of which there were none) could be used as publications under 35 USC 102(b), it would have said so. The principle of *In re Gregg*, 44 CCPA 904, 244 F.2d 316, of not reading limitations into the statute, is clearly applicable here.

POINT 3.

On page 28 of the Court's decision there is listed eleven (11) prior decisions of this Court, all of which were relied upon by the Patent Office, in support of the Board's decision in these appeals, and the conclusion reached in the instant decision is that "in none of these decisions do we find any support for the position taken by the Patent Office nor anything inconsistent with our position in the instant case". Further, on page 29 of the decision, there appears the statement that "implicit in all of these cases is the concept of a certain degree of knowledge possessed by one skilled in the arts involved concerning the disclosure of the prior publication and the concept which was sought to be patented, to the end *that this knowledge taken with the disclosure of the printed publication*, was sufficient to place the disclosed invention in the possession of the public."

It is respectfully submitted that it is indeed surprising and disturbing for this Court to say now that these decisions were based upon facts which the

decisions fail to mention. The jurisdiction of this Court at the time these decisions were made, as it is today, was limited to a hearing and determination of the appeal on the evidence submitted before the Patent Office. None of these decisions contains any indication or reference to the purported "degree of knowledge possessed by one skilled in the art", except possibly the Michalek case, referred to on page 30 of the decision. Under the limited jurisdiction given this Court by Congress this knowledge could have been properly considered only if evidence had been submitted before the Patent Office on this question, or in lieu thereof, the Court had taken judicial notice thereof. However, the decision in Michalek was based upon the fact that the patent relied upon as a reference disclosed a process for making the claimed product, and that the process disclosed in the patent, as shown by the evidence submitted by the appellants, produced a resin product which met the limitations of the appealed claims. The Court's discussion in that case as to what one skilled in the art would do with the reference process, which is referred to on page 30 of the instant decision, must and should be considered in the light of the established rule that there is a presumption of operability attaching to the grant of a U. S. Patent. *Grissinger v. U. S.*, 77 Ct. of Claims 106; cert. den. 290 U. S. 676; *Power Kennedy v. Concrete Mixing Corp.*, 282 U. S. 172; *Western States Machine Co. v. Hepworth Co.*, 147 F.2d 345, cert. den. 325 U. S. 873. Furthermore, since the decision in the case was not grounded on that discussion, it obviously was immaterial to the

holding made, which was based wholly on the evidence before the court. Since all cases must be decided on the record presented, implying knowledge at this late date is judicially unsound.

Insofar as the decision in the instant case states that "we disagree with them" (referring to the listed prior decisions of this Court), to the extent that these decisions may conflict with the present analysis of the Cohn case, the decision needs clarification. For more than thirty years this Court has consistently held that where a product is clearly disclosed in a prior publication, that disclosure is sufficient to anticipate a later claim therefor. Admittedly, this Court's prior decisions on the question were based upon the decision in the Decker (36 App. D. C. 104) and Cohn cases. Although the instant decision (page 32) discusses the Decker case, and states that the court there erroneously construed the Cohn cases, because it took no note of the so-called "all important" words, as to knowledge in the art of how to make the patented corset, it may be said that this Court has taken no note of the other holdings in the Cohn case, holdings which had crystallized through the years into a "doctrine", that how to make is immaterial, if the claimed product is clearly disclosed in the prior publication. To break with that doctrine on the basis of a single sentence contained in a paragraph, which contains unequivocally a holding as to the immateriality of a disclosure of the process in the publication relied upon, and a holding that "it is enough for this case" that the claimed invention was clearly described in the publication, is judicially unjustified, unwarranted and unreasonable.

That this Court may disagree with the decisions of the District Courts in the Bifocal Lens case and the General Elec. case (page 27 of the decision) is not in itself, unusual or surprising. However, for the Court to state that the standard for publications applied by the District Court in Bifocal is somewhat uncertain, because of the use of the word "may" in the decision, is surprising, since the involved patent was held invalid, in view of an 1866 patent publication, even though the patentee did not tell how the lens could be made, and, in view of the history of the art, it was highly doubtful whether he ever made one or whether anyone knew how one could be made. Further, the fact that the Court of Appeals was satisfied that the District Court reached just conclusions as to the issues involving the product patent, and that the Supreme Court denied certiorari, should have indicated at least that those courts were not "uncertain" as to the standard applied by the District Court, and that it was applied properly.

The Court's comment on the Shell case (page 32 of the decision) emphasizes that it cites the Merck case, and because of that construes the word "comprehend" used therein to include not only the printed publication, but in addition the knowledge possessed by the art, because of the fact that one witness in Merck expressed the opinion that he would have been able to make the claimed compound with little difficulty. Despite this opinion evidence, it is clear that the court in Merck held that no practical means for isolation or manufacture of the compound was previously known, and even on that basis denied the

application for patent, because of a prior disclosure of the compound. In the Shell case the testimony was that there was no knowledge in the prior art as to the claimed compound or method of making it. A bare formula existed in the publication relied upon and the term "comprehend" was intentionally used because of the use of the same term in the Cohn case, and the structural formula was considered sufficient to describe the claimed compound in a manner understood and comprehended by those skilled in the art. These are matters of record in the Court of Appeals of the District of Columbia, and if the term "comprehend" used by that court is to be construed, it would appear more appropriate to construe it in the light of the facts of that case.

CONCLUSION

In view of the foregoing, it is earnestly urged that the Court reconsider and re-analyze the decision of May 4, 1962 in these appeals. The long settled doctrine of this Court and that of other courts, which have thoroughly considered and evaluated the Cohn v. Corset Co. case should not be discarded, because, as to plant patents, there is no possibility of producing the plant from a disclosure thereof. The fact that Congress was aware of this situation and yet made no provision in Section 102(b) to exclude plant disclosures as references needs considered treatment. Upon further consideration it is believed that the Court will reach the conclusion that there was error

in its decision which requires correction, clarification,
and modification.

Respectfully submitted,

CLARENCE W. MOORE,
Attorney for Defendant

J. SCHIMMEL
Of Counsel

May , 1962.

**United States Court of Customs
and Patent Appeals**

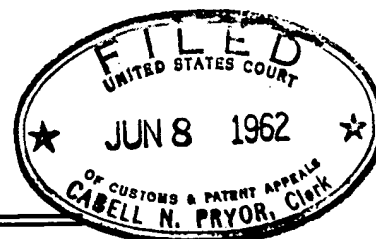
Patent Appeals Nos. 6727 and 6728.

**IN RE: APPLICATIONS OF
EDWARD BURTON LEGRICE
FOR: ROSA FLORIBUNDA PLANT.**

**BRIEF OF APPELLANT IN OPPOSITION TO PETITION
FOR RECONSIDERATION AND REHEARING.**

**JOHN HARROW LEONARD,
1562 Hanna Building,
Cleveland 14, Ohio,
*Attorney for Appellant.***

**SPENCER B. MICHAEL,
Woodward Building,
Washington, D. C.,
*Of Counsel.***



United States Court of Customs and Patent Appeals

Patent Appeals Nos. 6727 and 6728.

IN RE: APPLICATIONS OF
EDWARD BURTON LEGRICE
FOR: ROSA FLORIBUNDA PLANT.

BRIEF OF APPELLANT IN OPPOSITION TO PETITION FOR RECONSIDERATION AND REHEARING.

To The U. S. Court of Customs and Patent Appeals:

The appellant objects to the Petition for Reconsideration and Rehearing for the following reasons:

1. The Petition discloses no manifest errors, but merely reargues the original issues.

2. The Petition shifts from the original position that the words "printed publication" should be "taken in their exact and unequivocal meaning," (p. 2, lines 3 to 8 from last), to the position that they must be interpreted, but have been interpreted incorrectly (page 8, lines 2 to 9 from last).

On page 8 it is argued that the court misapprehended "the standards and principles applied by the courts for more than a half-century in determining the meaning of statutory language similar to the language in 35 USC 102(b), i.e., described in a printed publication."

3. The petition quotes a portion of a Supreme Court decision which this Court relied on in holding that a publication must be enabling, and then denies that the quotation states what is quoted.

Page 9, lines 8-22 reads as follows:

"Attention is directed to the statement by the Supreme Court that 'the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention and to carry it into practical use.' The Supreme Court does not say that the description of the publication must be 'enabling.' All that it holds is that it must be sufficient to enable the art to 'understand' the invention. It is submitted that 'understanding' is not the same as 'enabling.'"

The Petitioner's quotation indicates that the Supreme Court said exactly what the Petitioner now denies it said.

Further, how can one "understand" or "comprehend" a non-existent article, a mere figment of the imagination, which is incapable of being made a reality in any way presently known?

The Constitutional basis of the patent law infuses throughout the entire patent system, applications and prior art alike, the concept of "useful" res, not flights of fancy incapable of reduction to practice.

The petition states that some court decisions have not specifically pointed out that the thing shown in a prior description must be capable of being made by some procedure therein disclosed or known in the art. In dealing with "useful" arts and knowledge, the fact that an article described cannot be useful unless capable of being made apparently was considered so self evident that the courts thought it unnecessary to belabor the point by making a specific statement to that effect.

The petition, beginning page 17, argues that since no "enabling" description of plants is possible, the requirement of an enabling description which cannot exist is tantamount to rewriting the statute, and that it is unrealistic

to assume that Congress did not intend to make a plant publication available as a reference. This ignores this Court's recognition of the fact that such a description is not possible *at present*, but might become possible in the future.

There are a large number of inventions as to which no enabling description was possible at the time of passage of the patent statutes, but it was contemplated by Congress that, should an enabling description later become a reality, the statutes would apply. For example, an enabling description of "television" did not exist a century ago, and no doubt most people then living would have questioned the sanity of one who suggested it as a future possibility. Certainly Congress did not mean to pass statutes to advance the *useful* arts by granting a monopoly to a contributor of a *useful* thing and by the same statute to wreck its own handiwork by withholding the monopoly because of an earlier chimera.

It is believed that the Court properly interpreted the law and decisions and that the petition should be denied.

Respectfully submitted,

JOHN HARROW LEONARD,

1562 Hanna Building,
Cleveland 14, Ohio,

Attorney for the Appellant.

SPENCER B. MICHAEL,

Woodward Bldg.,
Washington, D. C.,

Of Counsel.